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March 29, 2006

Via First Class Mail

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

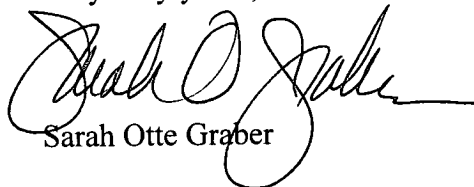
Re: U.S. Trademark Application Serial No. 76/572,253
Opposition No. 91165809
TriForest Enterprises, Inc. v. Nalge Nunc International Corporation
Our Ref.: NAC-125OP

Dear Madame:

Enclosed find the following in connection with the a above-referenced Opposition proceeding:

1. Applicant's Motion to Compel and Motion for Protective Order
2. Applicant's Memorandum in Support of Its Motion to Compel and Motion for Protective Order
3. Exhibits 1- 8

Very truly yours,



Sarah Otte Graber

Enclosures

cc: Denise Riemann, Ph.D., Esq. (w/ Enclosures)

K:\NAC\125OP\Correspondence\Cheng Ltr - 3-29-06.wpd



04-10-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #3:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF: _____

TriForest Enterprises, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91165809
)	Application No.:76572253
Nalge Nunc International Corporation,)	Mark: plastic water bottle (design only)
)	
Applicant.)	
_____)	

**APPLICANT'S MOTION TO COMPEL
AND MOTION FOR PROTECTIVE ORDER**

Pursuant to 37 C.F.R. § 2.120(e) and (f), §2.127 and Rule 37 of the Federal Rules of Civil Procedure, Applicant, Nalge Nunc International Corporation, moves the Trademark Trial and Appeal Board ("Board") for an order compelling Opposer, TriForest Enterprises, Inc., to properly and fully answer the discovery requests that Applicant has served on Opposer, including interrogatories, and document requests prior to the beginning of Applicant's Testimony Period on May 28, 2006. Applicant also moves the Board for entry of a protective order in order to facilitate the discovery of information and documents that Opposer has deemed "confidential." Applicant has made a good faith effort to resolve this discovery issue with Opposer and its counsel prior to filing these Motions, but was unable to reach an agreement. These Motions are supported by the accompanying Memorandum in Support and exhibits thereto.

WHEREFOR, Applicant respectfully requests that the Board grant these Motions.

Date: March 29, 2006

Respectfully submitted,
Nalge Nunc International Corporation



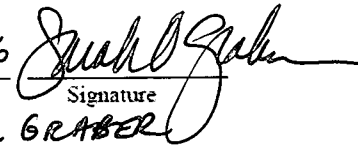
Sarah Ote Graber, Esq.
Theodore R. Remakius
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Attorneys for Applicant,
Nalge Nunc International Corporation

Certificate of Mailing

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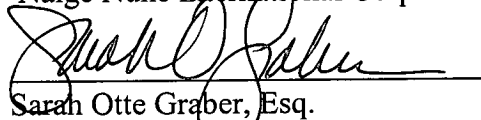
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

on 3/29/06 
Date Signature
SARAH O. GRABER

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S MOTION TO COMPEL AND MOTION FOR PROTECTIVE ORDER** was served by Federal Express, Two-Day Delivery, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92703, on this 29th day of March, 2006.

Nalge Nunc International Corporation

A handwritten signature in black ink, appearing to read "Sarah Otte Graber", is written over a horizontal line.

Sarah Otte Graber, Esq.

Wood, Herron and Evans

2700 Carew Tower

441 Vine Street

Cincinnati, Ohio 45202-2917

Attorney for Applicant,

Nalge Nunc International Corporation

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

on 3/29/06 Sarah O. Graber
Date Signature
SARAH O. GRABER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF:

TriForest Enterprises, Inc.,)
)
Opposer,)
)
v.)
)
Nalge Nunc International Corporation,)
)
Applicant.)
_____)

Opposition No. 91165809
Application No.: 76572253
Mark: plastic water bottle (design only)

**APPLICANTS' MEMORANDUM IN SUPPORT
OF ITS MOTION TO COMPEL
AND MOTION FOR PROTECTIVE ORDER**

Applicant files this Memorandum in Support of its Motion to Compel and Motion for Protective Order.

Applicant, Nalge Nunc International Corporation ("Nalge Nunc") served Opposer, TriForest Enterprises, Inc. ("TriForest") with interrogatories, document requests, and request for admissions on January 26, 2006. Because Opposer had not served any discovery requests on Applicant during the entire discovery period, Applicant was not sure if the proceeding was moving forward. On February 28, 2006,¹ Opposer served Applicant with written responses to Applicant's interrogatories, document requests, and request for admissions and a CD with copies of various documents.² Because most of the answers are deficient and Applicant would have to copy most, if not all, of Opposer's responses, Applicant is attaching Opposer's complete responses rather than inserting each individual request and response into this memorandum. Therefore, copies of Opposer's written responses, which include Applicant's original requests, are attached as Exhibits 1, 2, and 3. Opposer's written responses to Applicant's discovery

¹ Applicant actually received these answers on March 3, 2004, because they were sent by U.S. first class mail.

² It should be noted that Opposer's Responses to Applicant's Interrogatories were not signed, as required under TMBP § 405.04(c), but attorney for Opposer has confirmed that Opposer will be providing an adequate signature for these responses.

requests are deficient for one or more reasons. In particular, Applicant finds Opposer's responses to Interrogatory Nos. 1, 2-9, 11-33, and 35-39 to be evasive, insufficient, nonresponsive and more. In addition, Opposer has failed to produce all responsive documents. Opposer stated that it "will produce documents all responsive documents" to all of Applicant's document requests, but the documents submitted are irrelevant, unresponsive and/or incomplete. Applicant has attached a proposed Protective Order, as Exhibit 4.

The attorney for Applicant confirms that a good faith effort has been made by correspondence to resolve with the attorney for Opposer the issues presented in the present motions. In particular, in a letter dated March 27, 2006, the attorney for Nalge Nunc set forth the reasons why the subject interrogatories and document product request were insufficient and unresponsive. A copy of this letter is attached as Exhibit 5. However, in an email dated March 28, 2006, the attorney for Opposer continued to refuse to provide substantive answers and responsive documents to the subject interrogatories and documents production. A copy of this letter is attached hereto as Exhibit 6. Rather the attorney for TriForest continues to ignore the simple and direct issues of Applicant's discovery requests and provides further confusing and convoluted statements that are not comprehensible, or are irrelevant to the present opposition. Applicant spoke directly with Opposer's attorney on March 29, 2006, to seek clarification to his letter. In an additional email to Applicant also dated March 29, 2006, attorney for Opposer avoids making a similar determination, what Applicant's mark looks like. A copy of this email is attached hereto as Exhibit 7.

I. INTRODUCTION

This proceeding relates to Opposer's claim that the nature of Applicant's mark, the design of the configuration of a water bottle, subject of U.S. Application Serial No. 76/572,253, is

functional and lacks secondary meaning. (Notice of Opposition at ¶ 3, as numerated for clarification by Applicant).

These present motions concern Opposer's refusal to provide substantive responses to almost all of Applicant's discovery requests related to Opposer's potential or alleged harm, Applicant's mark, Opposer's awareness of third-parties' uses of similar or alternative bottle designs, and other relevant issues to this proceeding. Opposer also submits baseless objections against several requests as being vague or broad or requesting confidential information. To remedy the latter, Applicant hereby submits a proposed Protective Order and moves for the Board to enter this order to facilitate the discovery of relevant information. Lastly, Applicant submits that several of Opposer's responses are irrelevant to the present proceeding and have been submitted to misrepresent Opposer's alleged harm.

II. RELEVANT STATUTORY AUTHORITY

37 C.F.R. § 2.210(a) provides, in relevant part:

The provisions of the federal rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section.

The Federal Rules for Civil Procedure, in turn, provide for broad discovery. Specifically, Rule 26(b)(1) provides:

Parties may obtain discovery regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action, whether it relates to the claim or defense of the party seeking discovery or to the claim or defense of any other party including the existence, description, nature, custody, condition and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter. The information sought need not be admissible at trial if the information sought appears be reasonably calculated to lead to the discovery of admissible evidence.

Similarly, the scope of interrogatories is equally broad.

Interrogatories may relate to any matters which can be inquired into under Rule 26(b)(1), and the answers may be used to the extent permitted by the rules of evidence.

An Interrogatory otherwise proper is not necessarily objectionable merely because an answer to the interrogatory involves an opinion or contention that relates to fact or application of law to fact, but the court may order that such an interrogatory need not be answered until after designated discovery has been completed or until a pre-trial conference or other later time.

Fed. R. Civ. P. 33(c). Finally, document requests may also seek equally broad discovery.

Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on the requester's behalf, to inspect and copy any designated documents (including writings, drawings, graphs, charts, photographs, phonorecords, and other data compilations from which information can be obtained, translated, if necessary, by the respondent through detection devices into reasonably usable form), or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon which the request is served; . . .

Fed. R. Civ. P. 34(a).

III. ARGUMENT

The basis of Opposer's opposition is its contention that "it/he/she will be damaged by registration of the mark shown in [Application Serial No. 76/572,253] of Nalge Nunc International Corporation." (Notice of Opposition at ¶ 1). Opposer alleges that Applicant's mark is "functional and does not have secondary meaning." (Notice of Opposition at ¶ 3, as numerated for clarification by Applicant). In several interrogatories and document requests, Applicant requested information and documents from Opposer regarding its selling, distributing, manufacturing, marketing, promoting, or licensing any products that is one of the following:

- 1) "Applicant's Mark or a configuration similar to Applicant's Mark, including without limitation, the configuration shown in U.S. Patent Application 10/759,659,"

- 2) "Applicant's Mark or a configuration similar to Applicant's Mark,"; or
- 3) "Applicant's Bottle Configuration."

Opposer did not answer these interrogatories or requests, and stated as much. Opposer primarily responds that "[b]ecause the products are difficult to define, this interrogatory cannot be answered." See Opposer's Responses to Interrogatory Nos. 7, 18, 20-23, 27, and 36.

The terms "Applicant's Mark" and "Applicant's Bottle Configuration" were clearly defined in Applicant's Instructions and Definitions as the following:

The phrases "Applicant's Mark" or "Applicant's Bottle Configuration" refers to the mark as depicted in U.S. Trademark Application Serial No. 76/572,253. (Applicant's Instructions and Definitions, ¶ C.)

Opposer even refers directly to Applicant's mark as "the mark shown in [Application Serial No. 76/572,253] of Nalge Nunc International Corporation." (Notice of Opposition at ¶ 1). Moreover, 37 CFR § 2.52 explicitly requires that "[a] drawing depicts the mark sought to be registered." Copies of Applicant's original and amended drawing pages are attached as Exhibit 8. Nothing could be more understandable than a picture of Applicant's mark. Therefore, this blanket response that Opposer provides to many of Applicant's interrogatories is completely baseless and insufficient. Opposer understood the meaning of "Applicant's Mark" and "Applicant's Bottle Configuration" enough to file an opposition and to answer other interrogatories and admissions that incorporate these exact phrases. (See, Opposer's Responses to Applicant's Interrogatory Nos. 1, 2, 10, and 34; See Opposer's Responses to Applicant's First Set of Requests for Admissions.) Opposer clearly understands what "Applicant's Mark" entails and is simply avoiding very direct, relevant questions that go to the heart of determining, 1) if Opposer even has any harm or potential harm if Applicant obtains a registration of its mark, and 2) factors relevant to determining functionality of a mark.

Opposer provides answers that give the impression that it has been harmed by Applicant asserting its trademark rights. (Opposer's Responses to Applicant's Interrogatory Nos. 1, 3, 7, 16, and 17.) Opposer mentions that it "agreed to change the product configuration." (Response to Interrogatory Nos. 1.) This is not, in fact, true. Upon Applicant's requests, Opposer agreed to change one of its water bottle products that had a "wide-mouth" opening, i.e., a wider opening than that on Applicant's mark. Opposer did not agree to Applicant that it would change any bottle configurations that looked similar to Applicant's mark. Moreover, Opposer asserts that Applicant has sent numerous cease and desist letters to various third-parties, which is also not true. Thus, not only is Opposer avoiding answering the questions at hand, it is submitting hearsay information and speculations that are not, in fact, true. As Applicant informed Opposer, except for its Responses to Interrogatory Nos. 2, 10 and 34, Applicant considers Opposer's Responses to its interrogatories and document requests to be incomplete, insufficient or unanswered and its objections thereto to be baseless.

Additionally, Opposer objected to answering several interrogatories and documents requests on the basis that the information or documents sought are confidential and/or trade secret. Applicant certainly understands the sensitivity of such information. However, Opposer made no effort to provide a protective order, which would allow such information to be produced. It has been recognized that third-parties' products with alternative shapes, the cost of manufacture of a product with a particular product configuration, the costs of products with relevant product configurations, to name a few, are all relevant factors in determining the functionality and non-functionality of a product configuration mark. Inwood Laboratories, Inc. v. Ives Laboratories, Inc. 456 U.S. 844, (1982), Valu Engineering, Inc. v. Rexnord Corporation 278 F.3d 1268 (Fed. Cir. 2002) *citing* In re Morton-Norwich Products, Inc. 671 F.2d 1332 (CCPA 1982) Therefore, the information Applicant is seeking is relevant and goes to the primary issue of Applicant defending that its mark is not functional, should Opposer prove

standing and meet its burden of proof. Accordingly, Applicant hereby requests that the Board enter the attached proposed Protective Order to facilitate the production of this information and documents.

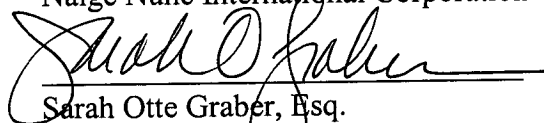
In general, Applicant considers the majority of Opposer's responses to its interrogatories and documents requests to be evasive, insufficient or completely unresponsive. "The responding party must answer each interrogatory separately, fully, and in writing." Moore § 33.101, p. 33-66. "Each interrogatory shall be answered . . . **fully**." Fed. R. Civ. P. 33(b)(1) (emphasis added). Thus, Opposer is required to provide full, complete, explicit, evasive and responsive answers and documents to Applicant's propounded interrogatories and documents requests. Opposer has failed to do so. Accordingly, Opposer should be compelled to provide a full and complete disclosure of facts and documents to Applicant before the beginning of Applicant's Testimony Period on May 28, 2006.

IV. CONCLUSION

For all the foregoing reasons, Applicant requests that its Motion to Compel and its Motion for Protective Order be granted to compel Opposer to provide full and complete disclosure of responsive information and documents before the beginning of Applicant's Testimony Period. Applicant wishes to note that it is not requesting that the Discovery Period be reopened.

Date: March 29, 2006

Respectfully submitted,
Nalge Nunc International Corporation

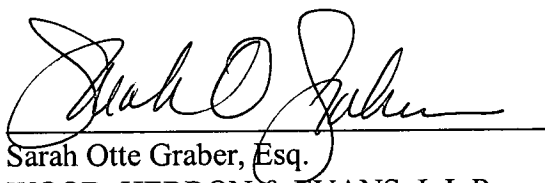

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Cincinnati, Ohio 45202-2917

Attorneys for Applicant,

Nalge Nunc International Corporation

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S MOTION TO COMPEL AND MOTION FOR PROTECTIVE ORDER and APPLICANTS' MEMORANDUM IN SUPPORT OF ITS MOTION TO COMPEL AND MOTION FOR PROTECTIVE ORDER was served by Federal Express, Two-Day Delivery, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92703, on this 29th day of March, 2006.

A handwritten signature in black ink, appearing to read "Sarah Otte Graber", is written over a horizontal line.

Sarah Otte Graber, Esq.
WOOD, HERRON & EVANS, L.L.P.
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441 Vine Street
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(513) 241-2324

Attorneys for Applicant,
Nalge Nunc International Corporation

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<u>In re Application, Serial No. 76/572,253</u>)	
TriForest Enterprises, Inc.)	
)	Opposition No.: 91165809
Opposer,)	
)	
Nalge Nunc International Corporation,)	
)	
Applicant/Respondent.)	
_____)	

**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S
FIRST SET OF INTERROGATORIES**

In accordance with Rule 34 of the Federal Rules of Civil Procedure and Rules 2.116 and 2.120 of the Trademark Rules of Practice, TriForest Enterprises, Inc. ("TriForest") responds to the following interrogatories of Nalge Nunc International Corporation ("Nalge").

GENERAL STATEMENTS AND OBJECTIONS

General Statements

- A. Responding Parties reserve the right to supplement or amend these responses in the event that any facts, documents, or other evidence may subsequently be discovered.
- B. These responses are made without prejudice to Responding Parties right to introduce facts, documents, witnesses, or other evidence may be subsequently discovered.
- C. These responses are made without prejudice to Responding Parties' right to supplement or amend these responses in the event that any information previously available to Responding Parties may have been omitted by oversight, inadvertence, or good faith error or mistake.

- D. Except for the facts explicitly stated herein, no incidental or implied admissions are intended.
- E. Responding Parties expressly reserves:
 - a. All objections regarding the competency, relevance, materiality, probative value and admissibility of all information provided, documents produced and the contents thereof;
 - b. All objections as to vagueness, ambiguity, unintelligibility and overbreadth.
- F. Nothing Herein shall be construed as an admission by Responding Parties regarding the admissibility or relevance of any fact or document or of the truth or accuracy of any characterization contained in Propounding Parties' discovery requests.
- G. These responses are signed by counsel only as to the objections set forth in the responses. Responding parties specifically claims the attorney-client privilege and/or the attorney-work product privilege as to each and every response set forth herein.
- H. The fact that part or all of any discovery request has been answered should not be construed to be a waiver of any objection to any discovery request.
- I. Responding Parties responds to each and every discovery request subject to the foregoing, and each of the forgoing statements and objections is incorporated by reference into each of the following responses.

General Objections

- A. Opposer objects to these requests to the extent they seek the production of information, documents or things, which are subject to the attorney client privilege, attorney work product or other privilege or exemption from discovery.
- B. Opposer objects to these requests to the extent they seek the production of information, documents or things, which constitute or would reveal trade secrets or confidential business information belonging to Opposer.

C. Opposers objects to these requests in so far as they seek the production of information, documents or things which are irrelevant or in material and are not reasonably calculated to lead to the discovery of admissible evidence, are not within the possession or control of Opposer, or are otherwise beyond the scope of the Federal Rule of Civil Procedure.

INTERROGATORIES

INTERROGATORY NO. 1:

Identify in detail each good with which Opposer has used, uses and intends to use Applicant's Mark or a configuration similar to Applicant's Mark, including without limitation, the configuration shown in U.S. Patent Application 10/759,659.

RESPONSE TO INTERROGATORY NO. 1:

Opposer previously sold the boston round that was claimed to be infringing. After receiving cease and desists from Apogent, opposer agreed to change the product configuration. Opposer incurred substantial cost to change the product configuration.

The opposer has no intent to use the functional features that are claimed in applicants mark, but would certainly like to because the particular features all have different utilitarian advantages. Opposer would like to avoid litigation and would only use the set of functional features if this opposition is successful.

INTERROGATORY NO. 2:

Identify the persons most knowledgeable about Opposer's sales, marketing, distribution, advertising and promotion, use and licensing of goods identified in response to Interrogatory No. 1.

RESPONSE TO INTERROGATORY NO. 2:

Steve Lin

INTERROGATORY NO. 3:

For each of the goods identified in response to Interrogatory No. 1, identify the first date, and each month thereafter, when Opposer used such goods, and produce all documents supporting such information.

RESPONSE TO INTERROGATORY NO. 3:

The Boston round has been sold as early as 2001 and in various configurations thereafter. The original product was canceled due to Apogent's threats, parent company of applicant.

INTERROGATORY NO. 4:

Identify each country, state or city, its territories and possessions, in which Opposer:

- A. is formally organized;
- B. is qualified under applicable law to do business as a foreign entity;
- C. has corporate headquarters maintained, including the exact street address and phone number of Opposer's main office; and
- D. owns, maintains or leases office or warehouse space.

RESPONSE TO INTERROGATORY NO. 4:

Opposer is a California corporation and other details are available at the Secretary of State website.

INTERROGATORY NO. 5:

Describe in detail the corporate structure of Opposer, including the identity of any and all entities related to or affiliated with Opposer.

RESPONSE TO INTERROGATORY NO. 5:

The opposer objects to this interrogatory as seeking trade secret information. Opposer objects to the interrogatory as not relevant.

INTERROGATORY NO. 6:

Identify all officers of Opposer since 2000.

RESPONSE TO INTERROGATORY NO. 6:

The opposer objects to this interrogatory as seeking trade secret information. Opposer objects to the interrogatory as not relevant. The officer would not be available in any case because the discovery cut off has terminated all right to depositions. Without waiving any of the objections, Steve Lin has been an officer since 2000.

INTERROGATORY 7:

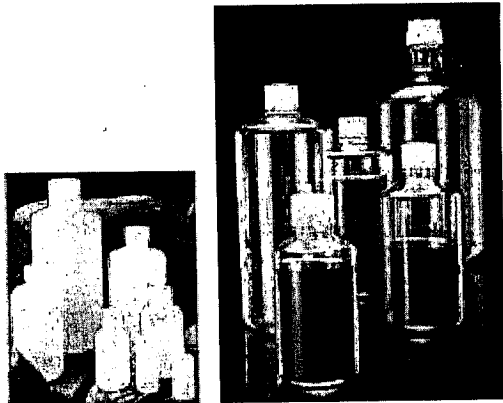
Identify all products or devices manufactured or distributed by Opposer that Opposer believes is or will be adversely affected by the registration of Applicant's Mark.

RESPONSE TO INTERROGATORY NO. 7:

The cease and desist letters contain allegations that substantially broaden the original

Patent like claims issued by the trademark Office. Therefore, opposer is not able to figure out exactly which products it will suffer legal problems but it could be many. A simple pictorial argument is as follows:

Start with a Nalgene Boston Round Lab bottle



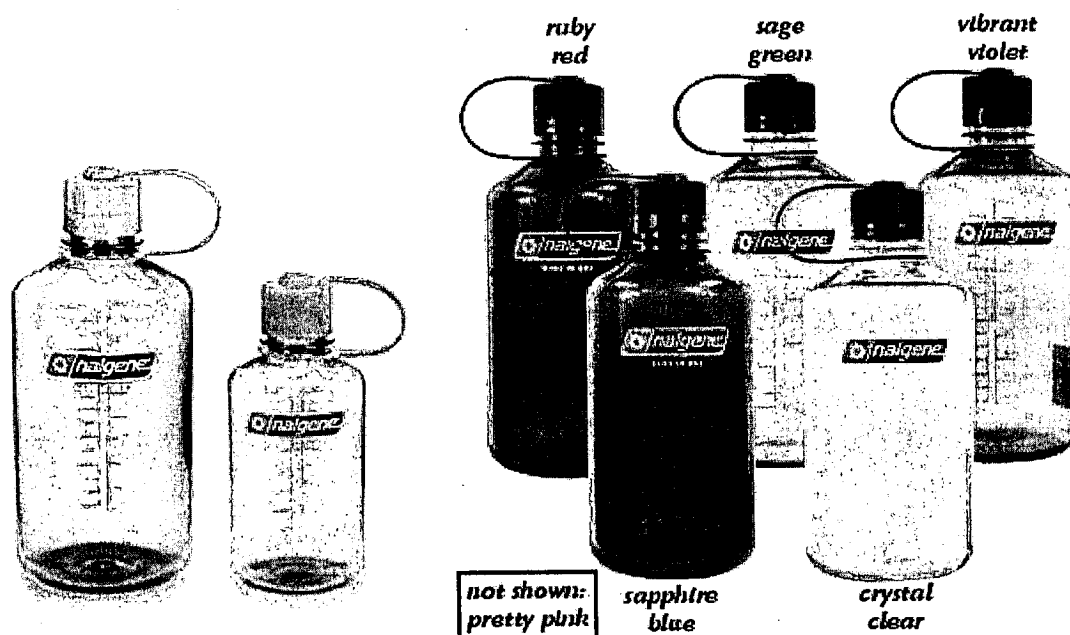
Add the tether cap



to create these Nalgene items



Now Nalgene claims to have a mark on the diverse bottles as shown:



INTERROGATORY NO. 8:

Describe in detail all past, existing and potential relationships, including, without limitation, contracts, agreements, licenses, assignments, negotiations to license or other grant of rights, or other relationships, between Opposer and any third party, relating to products bearing Applicant's Bottle Configuration or a similar configuration.

RESPONSE TO INTERROGATORY NO. 8:

Opposer objects to this interrogatory as over broad, compound and is difficult to logically answer. Opposer does not license the product and does not have a claim to applicants bottle configuration. Opposer believes that applicants bottle configuration is a public domain configuration that does not have distinctive relationship to any particular source of goods.

INTERROGATORY NO. 9:

For each product identified in response to Interrogatories Nos. 1 and 7, state the date of first sale in the United States.

RESPONSE TO INTERROGATORY NO. 9:

Because the opposer did not exist before Dec 2001, the first date of the earliest sale of any bottle would be after 2001.

INTERROGATORY NO. 10:

For each product identified in response to Interrogatories Nos. 1 and 7, list all persons

knowledgeable about the sales, accounting, distribution and promotion of such product(s).

RESPONSE TO INTERROGATORY NO. 10:

Steve Lin

INTERROGATORY NO. 11:

Set forth with specificity the circumstances and all facts regarding, relating or referring to the selection by Opposer of the configurations of the goods identified in response to Interrogatory No. 1, and identify all documents related thereto.

RESPONSE TO INTERROGATORY NO. 11:

The applicant has the current statement of the trademark in the trademark Office as: The mark consists of a plastic water bottle as shown, namely, a plastic water bottle having a transparent, generally cylindrical container body with rounded shoulders interconnecting the upper and lower extremities of a cylindrical sidewall to a relatively narrow container neck and a generally flat, circular container bottom, respectively; an opaque screw cap releasably engaged with threads on the upper portion of the neck and having a button connected to the center of its top surface via a short stem; and a strap terminating in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, wherein the ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately 0.4 and the ratio of the height of the generally cylindrical container body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8.

The opposer designed the original bottle based on a review of various Boston round designs. The opposer then created the original bottle based on efficient engineering principles. The original bottle is made of plastic because plastic is a good material to make a water bottle. Plastic is generally well accepted as a way of making a bottle. Plastic is relatively inexpensive compared to stainless steel or silver. Plastic is watertight and can seal water within a closed container. Plastic can also be formed with a closure that is threaded and watertight. Plastic is a petroleum derivative that is relatively abundant compared to metal. The opposer did not make the bottles out of wood, stone or soap because these materials are not as durable. A soap bottle would dissolve in water and a wooden bottle would split and is not well suited for holding a

liquid. During the autoclave process, the plastic is particularly well-suited for the construction of the bottle.

The opposer made bottles that were transparent so that users could look into the container and see if there are contents within the container. Transparency of the bottle also provides a user with the opportunity to determine the quantity of liquid within the bottle. Transparency also allows a user to determine if there are color changes or any other types of qualitative change within the bottle. Transparency is particularly useful during hiking because a foreign object could accidentally fall inside the bottle and a user may drink the foreign object by accident if the user could not see inside the bottle. In laboratory tests, a user may see foreign objects that have accidentally fallen inside of the bottle that may change the results of any laboratory tests. In laboratory use, the bottle often has a media inside that is supposed to be sterile. Having a transparent surface allows a laboratory worker to look inside of the bottle to see if there is anything foreign, such as an insect like a mosquito, fly, mayfly or cockroach. The transparency of the bottle is also helpful for a user because the user can see if the bottle is clean. If the bottle is dirty, the user may want to clean the bottle. If the user wants a dirty bottle, having a transparent surface would insure that there is debris in the bottle. Overall, transparent bottles have been in use since early glass bottles. Early glass bottles are ancient.

The bottle is generally cylindrical with rounded shoulders because some machines roll the bottle. Also, the bottle been generally cylindrical with rounded shoulders allows a greater volume to surface area ratio. This is helpful when optimizing construction so that the plastic use is minimized and the strength of the bottle is maximized. The rounded shoulders interconnect with the upper and lower extremities of the cylindrical sidewalls because if they were not connected, the bottle would fall apart and the contents will leak out. It is better that the bottles are made of integrally formed or blown pieces, rather than pieced together from a number of independent interlocking pieces.

The relatively narrow container neck is commonly known as a narrow mouth bottle. The narrow mouth bottle is good because it is easier to pour of the contents or to drink from the bottle. If the

mouth is too large, it is easier to spill all over the place. The narrow mouth bottle is a very good configuration. There are a wide number of narrow mouth bottles such as milk bottles. Milk is put into bottles that have a narrow mouth because this makes it easier to pour the milk. Orange juice is also put into bottles that have a narrow mouth because it is easier to pour the orange juice. A variety of liquids can be put into a narrow mouth bottle allowing easier pouring of the contents. This applies to granular media such as sand, or coffee grounds as well. When a person purchases a can of coffee at the store that is in the 5 lb. canned version, the person needs to use the scoop that that can comes with because it is hard to pour out of a can that has a large diameter. The contents will pour out of the middle portion of the mouth, but also out of the sides of the mouth. The stream of contents is proportional to the radius of the bottle opening.

The bottle has a generally flat container bottom that a circular because the bottle is in the shape of a cylinder. The circular bottom is formed by the bisecting plane between the cylinder and a plane. The flat bottom is very helpful. If the bottom is not flat, the bottle has a tendency to tip over. The bottle should not tip over. If the bottle tips over the contents will pour out. Having a flat bottom is the best way to keep the bottle from tipping over. Alternative methods such as using adhesive resin to bond the bottle to a table is not as good because the bottle would become stuck and difficult to remove from a table. The bottle could also be made to have a circular depression such that the bottom of the bottle forms a rim. This is helpful for strength of the bottle. If the bottle has a small circular depression or a broad one, the best way to make the bottle is with a flat bottom.

The screw cap is opaque and engaged with threads on the upper portion of the neck because transparent material is more expensive and difficult to work with on a screw cap. The screw cap should be softer and thus opaque materials are better at forming the screw cap. It would be more expensive to make transparent screw caps because the plastic is more expensive. If a user can see through the wall of the bottle, it is not that big of a deal that the user cannot see through the screw cap. The screw cap engages with threads because it is easier to screw on a bottle cap rather than snap it on. The snap on version is too easily snapped off. The screw configuration is a better way to seal the bottle with certainty.

The screw cap has a button connected to the center of its top surface via a short stem because the screw cap is tethered to the bottle. The tether rotates about the button that serves as an axis of rotation to retain the tether to the cap. Once the user takes off the cap, the tether is very helpful because otherwise the cap would be lost or roll away. The connection is formed as a button because the button configuration provides a good axial connection while maintaining low weight and cost. The button is essentially a rivet that turns. If the tether were directly formed to the screw cap, the screw cap would stop turning because the tether would bias the screw cap by exerting a clockwise force. Therefore, an axial connection is preferred. The tether connection to the shrink ring was the easiest connection. Other alternatives such as Sonic welding would require additional machinery and production process. The tether connection to the shrink ring provides a manual solution for connection.

The strap terminates in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, because the small ring is necessary for rotation with the cap, and the large ring is necessary for connection with the shrink ring. The button stem is preferably encircled because that provides a pivotal connection. The strap is visually distinct from the screw cap because they are separate parts. They are separate parts because the screw cap needs to rotate around the mouth of the bottle while the strap remains stationary. If the strap rotates with the screw cap, the strap will interfere with the hand of the user especially if the user is removing or putting the cap on using a single hand. The top ring is smaller because it does not need to be very large for the connection with the cap. Though bottom ring is larger because it must fit around the shrink ring near the base of the bottle. If the top ring were larger than the bottom, the ring would protrude over the top surface of the cap and hinder the fingers of the user. The top ring should be smaller than the top of the top surface of the cap because the fingers of the user preferably grasp the interface between the top surface of the cap and the side surfaces of the cap. The top ring being in the same size as the top surface of the cap would limit the user to grasping only the side surfaces of the cap. This limitation would prevent a user from tightening the cap as much as a user could have if the user had access to grab more surface area on the cap.

The ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately .4 because in a 500ml cylindrical container, that ratio produces a circumference that is approximately equivalent to the size of an average person's hand. The .4 ratio is particularly comfortable and easy to hold. If the container were overly long, it would require additional plastic to create and would not be as strong. The overlong container would also not be as strong because is more of a stick shaped container. The 500ml cylindrical container is a standard size. It is half a liter. A liter is a metric size. Metric units are widely adopted in the world. A metric units are particularly helpful in science because all of the unit's are based 10. Dealing with inches and feet, and gallons makes calculations difficult. Therefore, the standard size half liter container is particularly well-suited for a person's hand when .4 ratio is in place.

The ratio of the height of the generally cylindrical container body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8 because with the .4 ratio previously mentioned, the cap would be on the order of several inches in height. Having a cap that produces a .7 ratio would make the cap size overly long and create a long neck that is taller than it is wide. Having a cap that produces a .9 ratio would make the gripping area too small for an average person's fingers. Therefore, the .8 ratio is derived from the .4 ratio which is derived from the combination of the standard size 500ml container in combination with an average person's hand size.

The container is designed to hold water because it is a bottle. Water is the most plentiful liquid on the planet. A wide variety of liquids can be stored within the container. If the container were not designed to hold water, it would not work as well as a container that could hold water. Humans drink water during exercise and on a daily basis. Humans are comprised of a substantial percentage of water weight. Therefore, the opposer designed the bottle to hold water because holding water is a convenient and utilitarian function of a bottle.

INTERROGATORY NO. 12:

Identify all other configurations Opposer considered as alternatives to a water bottle

having Applicant's Bottle Configuration or a similar configuration, and produce all documents related thereto, including, but not limited to, photographs and drawings of such alternative configurations.

RESPONSE TO INTERROGATORY NO. 12:

For the above reasons previously stated, the opposer adopted a bottle that happened to be described in the description of the mark. The opposer adopted the bottle design described in the description of the mark because the description of the mark describes a typical narrow mouth bottle that has a tether.

INTERROGATORY NO. 13:

Identify all persons who were involved in the selection, design, development, adoption and use of a water bottle configuration having Applicant's Bottle Configuration, or a similar configuration, and for each person, state his/her title, and the role s/he played to select, design, develop, adopt and use such.

RESPONSE TO INTERROGATORY NO. 13:

The opposer does not have sufficient knowledge to answer this interrogatory other than to say that Owens Illinois made the first Boston Round configuration. Regarding the design, development, adoption and use of the standard water bottle configuration, these should be available on the United States Patent Office website or in other public domain databases.

INTERROGATORY NO. 14:

For each product identified in response to Interrogatories Nos. 1 and 7, explain in detail the reasons for selecting such product configuration.

RESPONSE TO INTERROGATORY NO. 14:

Please see answer to the interrogatory 11.

INTERROGATORY NO. 15:

For each alternative configuration identified in response to Interrogatory No. 12, explain in detail why such design was not selected.

RESPONSE TO INTERROGATORY NO. 15:

Please see answer to the interrogatory 11.

INTERROGATORY NO. 16:

Describe in detail all circumstances when Opposer has marketed, advertised, or promoted

a water bottle bearing Applicant's Bottle Configuration or a similar configuration, including the dates and media channels or such marketing, advertising or promotion, and identify all documents related thereto.

RESPONSE TO INTERROGATORY NO. 16:

The opposer sold the goods to the vendors that received the cease and desist letters from Apogent. Thereafter, the opposer's business in selling the goods was substantially harmed.

INTERROGATORY NO. 17:

When did Opposer first become aware of (1) Applicant, (2) Applicant's Mark and (3) the application of Applicant's Mark, namely, U.S. Application Serial No. 76/572,253.

RESPONSE TO INTERROGATORY NO. 17:

Opposer is not exactly sure of the dates, but knows that the notice of all these came from Apogent's cease and desist letters beginning in about September 2004.

INTERROGATORY NO. 18:

For each product identified in response to Interrogatory No. 7 state (1) the country(s) in which the product is manufactured and (2) the costs of manufacturing such product.

RESPONSE TO INTERROGATORY NO. 18:

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

INTERROGATORY NO. 19:

Identify all inquiries, investigations, surveys, evaluations and/or studies, legal or otherwise, conducted by Opposer or by anyone acting for or on its behalf with respect to use of a configuration similar to Applicant's Mark, including the date conducted, the name, address and title of each person who conducted it, the purpose of being conducted, the findings or conclusions made, and identify all documents related thereto.

RESPONSE TO INTERROGATORY NO. 19:

This interrogatory is objected to on the basis of seeking attorney work product that is attorney work product privileged. To the extent that discoverable evidence is not an attorney work product privileged, it is described below. Fisher Scientific owns Apogent that owns Nalgene. Fisher Scientific also owns Cole-Parmer.

1. The following sites have been used for searches on the Boston Round configuration indicating that Applicant's Mark is simply a connected cap on their existing (advertised) bottle listed as Boston Round.

- a. www.fishersci.com (Applicant's parent company)

- i. <https://www1.fishersci.com/Search;jsessionid=DtIVY6X66GHzkJN6LwuZvEf1Soi5i2JYnY5JAfTIuOTX5xrDO692!917591203?t=r&key=boston+round>

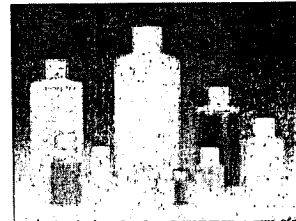
- ii.

Nalgene* Polypropylene Boston Round Bottles
Excellent chemical resistance

Fisher Catalog > Bottles > Plastic Bottles [General Purpose] > Round Plastic Narrow Mouth Bottles > Nalgene* Polypropylene Boston Round Bottles

With polypropylene screw closures. Ideal for lab applications requiring excellent autoclaving of containers with or without contents.

Note: Completely disengage threads or remove closure before autoclaving. Leakproof.¹



02-925 and 02-923-11
Series

- b. www.vwrsp.com

- i. <http://www.vwrsp.com/psearch/ControllerServlet.do?D=boston+round&CurSel=Ntt&Ntt=boston+round&Ntk=All&Ntx=mode%2bmatchpartialmax&Np=2&N=0&Nu=RollupKey&cntry=us&Nty=1&custpartgrp=null>

- c. http://www.coleparmer.com/opproducts/nalgene_bottles.html

Nalgene Bottles

Whether your laboratory storage needs include pharmaceutical, chemical, or other commercial applications, Cole-Parmer offers a wide selection of Nalgene® bottles. Choose from narrow-mouth, wide-mouth, wash, solution and other use bottles. Nalgene® bottles are available in various sizes and specifications including polypropylene and polyethylene. Check out our catalog's selections and you'll find the Nalgene® bottles with the features you need, like some of the features of the Model EW-06035-70 (pictured) listed below.

Nalgene Bottles Quick Link

Model EW-06035-70 — Nalgene® Narrow-Mouth High-Density Polyethylene (HDPE). All-purpose Boston round Nalgene® bottles are popularly used for packaging, shipping, and storage because of their reliable durability. Rigid, translucent, and chemical-resistant, Nalgene® bottles can be used with most corrosives. All have leakproof polypropylene (PP) screw closures.

d. <https://www1.fishersci.com/Coupon?cid=1328&gid=43890>



e.

**The Polycarbonate Boston Round Bottle with identical measurements, shape and profile being sold by the applicant's parent company without a tethered cap. Just as the opposer is selling a Boston Round Bottle is sold in the lab market with a tethered cap filled with reagents and culture media.*

Characteristics	Cat. No.	Qty.	Price
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[Add To Shopping Cart](#)

Screw Cap Size: 38mm-430; NNI
No.: 2205 0016; Capacity: 16 oz.

02-960-52E
NNI No.:2205-0016



- ☒ Pack of 4 for
\$37.64
- ☐ Case of 6 for
\$150.56

[Add To Shopping Cart](#)

Screw Cap Size: 38mm-430; NNI
No.: 2205 0032; Capacity: 1/4gal.

02-960-52F
NNI No.:2205-0032



- ☒ Pack of 4 for
\$52.64
- ☐ Case of 6 for
\$210.54

[Add To Shopping Cart](#)

f. www.nalgenepackaging.com

- i. http://www.nalgenepackaging.com/products/productDetail.asp?product_id=632&subcategory_id=&category_id=123&brand_name=NALGENE+Packaging&category_name=Lab+Quality+Bottles&subcategory_name=

g. <http://www.nalgene-outdoor.com/store/category.asp?category=Narrow-Mouth+Bottles>

h. <http://store.karstsports.com/nalnarmoutlo.html>

- i. Sports Market Distributor selling the same bottle with a tether cap and with screw cap without tether, being called narrow mouth bottle.

i. <http://www.rei.com/product/484.htm>

- i. Nalgene Narrow-Mouth Polyethylene Bottle - 16 oz.
\$4.25 Item 402188
Same bottle called Boston Round made with HDPE, LDPE.



INTERROGATORY NO. 20:

For each good sold by Opposer bearing Applicant's Mark or a similar configuration,

identify the target consumers or ordinary purchasers, including their sophistication, the level of care exercised by such customers or purchaser in purchasing such goods or services.

RESPONSE TO INTERROGATORY NO. 20:

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

INTERROGATORY NO. 21:

For each good Opposer sells and promotes, or intends to sell and promote, in connection with a water bottle bearing Applicant's Bottle Configuration or a similar configuration, identify with specificity the price range, at the wholesale and/or retail level, at which Opposer sells or intends to sell such goods, and identify all documents related thereto.

RESPONSE TO INTERROGATORY NO. 21:

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

INTERROGATORY NO. 22:

For each good identified in response to Interrogatories Nos. 1 and 7, set forth the dollar amount of the gross quarterly sales of such goods, if any, and the dollar amount of quarterly advertising expenditures.

RESPONSE TO INTERROGATORY NO. 22:

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition. Without waiving the objection that this interrogatory is vague, the opposer answers that the amount is insubstantial compared to the amount of sales of the applicant. The amount is insubstantial because of the unfair claiming of Patent features as trade dress features, and the related threats of litigation.

INTERROGATORY NO. 23:

Identify the date when a water bottle bearing Applicant's Bottle Configuration or a similar configuration was last sold by or on behalf of Opposer and provide all supporting documents thereto.

RESPONSE TO INTERROGATORY NO. 23:

The opposer objects to this interrogatory as being vague. Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

INTERROGATORY NO. 24:

Identify each statement or opinion, oral or written, obtained by or for Opposer regarding any issue in this Opposition proceeding, and identify all documents which record, refer to, or relate to such statement or opinion.

RESPONSE TO INTERROGATORY NO. 24:

This interrogatory is objected to as being over broad and vague.

INTERROGATORY NO. 25:

Identify all water bottle configurations used by third parties, registered or common law, for goods related to those goods listed in response to Interrogatory No. 1. Explain when Opposer first became aware of these configurations, what action Opposer has taken with respect to each of these trademarks, and the outcome of such action.

RESPONSE TO INTERROGATORY NO. 25:

The opposer has not compiled a comprehensive list of water bottle configurations used by third parties. The opposer reserves the right to supplement this interrogatory. So far, there are only the configurations in the production of documents and in the opposition.

INTERROGATORY NO. 26:

State in detail the channels of trade through which Opposer uses and markets, or intends to use and market a water bottle bearing Applicant's Bottle Configuration or a similar configuration, including the geographic area by state, the manner in which the goods reach the ultimate consumer, the specific names of retail store establishments, the approximate percentage of goods sold through each channel, and total sales, if any, of goods through each channel.

RESPONSE TO INTERROGATORY NO. 26:

Opposer plans to market in general retail and wholesale in the sports, general goods and laboratory markets.

INTERROGATORY NO. 27:

Identify with specificity the media and marketing methods used by or on behalf of Opposer in the promotion and sale of goods bearing Applicant's Bottle Configuration or a similar configuration without limitation, the names of newspapers, magazines, or periodicals.

RESPONSE TO INTERROGATORY NO. 27:

The opposer objects to this interrogatory as being vague. Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define.

INTERROGATORY NO. 28:

Identify all persons or entities, other than Applicant, and set forth with specificity all facts with whom Opposer has had contact regarding, relating or referring to Applicant's Mark, and identify all supporting documents related thereto.

RESPONSE TO INTERROGATORY NO. 28:

The opposer objects to this interrogatory as being vague and overbroad. Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define.

INTERROGATORY NO. 29:

Identify all plastic water bottles produced, manufactured or distributed by Owens-Illinois and Brockaway Glass.

RESPONSE TO INTERROGATORY NO. 29:

The opposer does not know all of the production of these companies. It is believed that these companies produce a wide variety of products.

INTERROGATORY NO. 30:

Describe, define or otherwise explain in detail the meaning of "standard sizes in the marketplace," "standard laboratory machines," and "related bottle holders" as used in the Notice of Opposition.

RESPONSE TO INTERROGATORY NO. 30:

The standard sizes in the marketplace refer to industry standards. Industry standards are common sizes or shapes that are adopted by a wide variety of companies in a particular field. For example, water bottles are typically sold in 500ml containers. Standard laboratory machines refers to machines that are configured and designed to accept a particular size or shape of container. For example, some laboratory machines roll the bottle for mixing. Square bottles do not roll very well. Therefore the standard in this case would be that the bottle is cylindrical. Related bottle holders refers to standard sized holders for the bottles. Because bottles are

standard sized, the bottle holders would be adapted to receive the standard sized bottles. The standard size is a result of various companies in the bottle industry making bottles that are of similar shape and size and dimensions. Because the various companies in the bottle making industry make bottles that are similar, laboratory machines will also make machines that receive those bottles.

INTERROGATORY NO. 31:

Describe in detail the cost of manufacturing the goods identified in response to Interrogatories No. 1 and No. 7.

RESPONSE TO INTERROGATORY NO. 31:

The opposer objects to this interrogatory as seeking confidential trade secrets, as irrelevant and as not calculated to lead to discoverable evidence.

INTERROGATORY NO. 32:

Explain in detail why Opposer filed a patent application for a water bottle having features similar to Applicant's Mark.

RESPONSE TO INTERROGATORY NO. 32:

Like the applicant, Opposer wanted to be able to sue people for making standard products. Unfortunately, opposer was thwarted by the patent office because of novelty issues.

INTERROGATORY NO. 33:

Identify each witness that Petitioner expects to testify, the subject matter to which the witness is expected to testify, each fact and/or opinion to which the witness is expected to give, the bases for each statement or opinion and identify all documents related thereto.

RESPONSE TO INTERROGATORY NO. 33:

The opposer has not figured out the witnesses yet. Witnesses may not be necessary if the opposer wins without trial. The opposer reserves the right to supplement this interrogatory.

INTERROGATORY NO. 34:

Identify each person who participated in or supplied information used in answering any of the above interrogatories; beside the name of each such person, state the number of the interrogatory answer(s) that person answered or supplied information.

RESPONSE TO INTERROGATORY NO. 34:

Steve Lin

INTERROGATORY NO. 35:

Identify all facts and documents supporting contention that in the Notice of Opposition that "[t]he 76572253 mark is functional and does not have secondary meaning."

RESPONSE TO INTERROGATORY NO. 35:

The answer to this interrogatory is in interrogatory response 11.

INTERROGATORY NO. 36:

Identify all facts and documents that Opposer claims show that the exclusive use by Applicant of Applicant's Mark would put competitors at a significant non-reputation-related disadvantage.

RESPONSE TO INTERROGATORY NO. 36:

The opposer objects to this interrogatory as being vague and overbroad. Applicant will have a perpetual patent claim that grows with time and has no certainty in the limitations and is not subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. The functional advantages of the product are previously described in interrogatory response 11.

INTERROGATORY NO. 37:

Identify all facts and documents Opposer claims show that there are no alternative designs available that are functionally equivalent to the design of Applicant's Mark.

RESPONSE TO INTERROGATORY NO. 37:

The patent like claim given to applicant will, from time to time, shed limitations and elements from the claim, until applicant has a monopoly on all water bottles. Apogent's cease and desist letters remove many elements and limitations from the patent like claim that was granted by the Trademark Office.

This pattern of unfair competition and misuse of trademark registration provides an unfair advantage to large corporations. As a small start up company involved in selling plastic consumables we are concerned with the unfair and the monopolistic trade practices of the giant corporations.

INTERROGATORY NO. 38:

Identify all facts and documents Opposer claims show the design of Applicant's Mark provides for a simpler or cheaper method of manufacture than alternative designs.

RESPONSE TO INTERROGATORY NO. 38:

The functional advantages of the product are previously described in interrogatory response 11.

INTERROGATORY NO. 39:

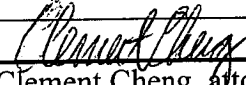
Identify all facts and documents supporting Opposer's contention in the Notice of Opposition that:

- A. "If the 76572253 mark is allowed to be registered, the applicant Nalgene would have a monopoly on the traditional Boston Round."
- B. "The applicant [sic, Opposer] also sells this type of bottle and would be injured if the application were registered."
- C. "The button is necessary to connect the tether in swivel configuration to the cap."
- D. "Opposer has filed a utility patent application for the connector 'tether' and opposer's bottle is also sold to the same customers."
- E. "The round profile contributes substantially to the strength of the bottle."
- F. "The upper annular ring is configured to allow a shrinkwrap machine shrinkwrap the top of the cap to the bottle."
- G. "The overall height of the water bottle and . . . are established by standard

sizes in the marketplace. The ratios are commercially necessary so that the bottles will fit into standard laboratory machines, packaging machines, and related bottle holders."

RESPONSE TO INTERROGATORY NO. 39:

The functional advantages of the product are previously described in interrogatory response 11. This interrogatory has been answered by the above responses to interrogatory 1-38. The opposer incorporates by reference the responses to interrogatory 1-38.

<u>2/28/06</u> Date (714) 825-0555; (714) 825-0558 fax	 Clement Cheng, attorney for applicant Newhope Law, PC 17220 Newhope St Ste 127 Fountain Valley, CA 92708-4283
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PROOF OF SERVICE

In the matter of App Ser. No. 76/572,253

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On February 28, 2006, I served:

**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S
FIRST SET OF INTERROGATORIES**

By placing true copies thereof in a seal envelope, addressed as follows to:

Donald L. Frei

Sarah Otte Graber

WOOD, HERRON & EVANS, LLP

2700 Carew Tower

441 Vine Street

Cincinnati, OH 45202-2917

(513) 241-2324

Attorney's for Applicant Nalge Nunc International Corporation

- ☒ **BY MAIL:** I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.
- ☒ **FEDERAL:** I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on February 28, 2006 at Fountain Valley, California.



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<u>In re Application, Serial No. 76/572,253</u>)	
TriForest Enterprises, Inc.)	
)	Opposition No.: 91165809
Opposer,)	
)	
Nalge Nunc International Corporation,)	
)	
Applicant/Respondent.)	
_____)	

**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S
FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS**

REQUEST FOR PRODUCTION NO. 1:

Produce all documents that record, refer to, or relate to the organization, incorporation, structure, operation and activities of Opposer insofar as they relate to any goods sold and/or intended to be sold, offered or promoted by Opposer in connection with or bearing Applicant's Mark or a similar configuration.

RESPONSE TO REQUEST FOR PRODUCTION NO. 1:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 2:

Produce all documents that record, refer to, or relate to any past, existing and potential relationships, including but not limited to licenses, assignments, agreements, contracts, or other arrangements, between Opposer, or a party on Opposer's behalf, and any third party that relate in any manner to bottles bearing Applicant's Mark or a similar configuration.

RESPONSE TO REQUEST FOR PRODUCTION NO. 2:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 3:

Produce documents sufficient to identify all goods with which Opposer manufactures, distributes or uses and/or intends to manufacture, distribute or use Applicant's Mark or a similar configuration.

RESPONSE TO REQUEST FOR PRODUCTION NO. 3:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 4:

Produce documents sufficient to identify all channels of trade through which Opposer's goods bearing Applicant's Mark or a similar configuration are sold or advertised and promoted or intended to be sold or advertised and promoted.

RESPONSE TO REQUEST FOR PRODUCTION NO. 4:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 5:

Produce all documents that record, refer to, or relate to Opposer's claimed use of a good bearing Applicant's Mark or a similar configuration for each month from Opposer's claimed first use date to the present.

RESPONSE TO REQUEST FOR PRODUCTION NO. 5:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 6:

Produce all documents sufficient to identify all of the target consumers and ordinary purchasers of Opposer's goods sold or advertised and promoted in connection with a water bottle.

RESPONSE TO REQUEST FOR PRODUCTION NO. 6:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 7:

Produce all documents that record, refer to, or relate to Opposer's advertising and promotion, intended advertising and promotion, marketing or business plans related to a water bottle bearing Applicant's Mark or a similar configuration.

RESPONSE TO REQUEST FOR PRODUCTION NO. 7:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 8:

For each good bearing Applicant's Mark or a similar configuration sold, distributed or promoted, or intended to be sold, distributed or promoted by or on behalf of Opposer, produce all documents that record, refer to, or relate to Opposer's gross sales, if any, or projected gross sales, by calendar quarter.

RESPONSE TO REQUEST FOR PRODUCTION NO. 8:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 9:

Produce all documents that record, refer to, or relate to any searches, investigations, studies, analyses, surveys or inquiries conducted by or on behalf of Opposer recording, referring or relating to Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 9:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 10:

Produce all documents that record, refer to, relate to, or are in any way concerned with the preparation, filing and/or prosecution of any applications, trademark, patent or otherwise, for a bottle configuration similar to Applicant's Mark or a similar configuration.

RESPONSE TO REQUEST FOR PRODUCTION NO. 10:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 11:

Produce all documents that record, refer to, or relate to Opposer's selection, adoption, design, development and use, including, but not limited to, photographs, drawings and specification sheets, and all drawings or documents related to rejected designs, of a water bottle configuration similar to Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 11:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 12:

Produce all documents that refer to or relate to communications, oral or written, made to third parties by Opposer regarding the use of a water bottle bearing a configuration similar to Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 12:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 13:

Produce a sample of each and every different advertisement, intended advertisement, item of promotional material and intended item of promotional material printed and disseminated, including, but not limited to, signs, displays, brochures, catalogs, websites,

mailers, price lists, etc., which is intended or has been used or disseminated at any time by or for Opposer bearing a water bottle configuration similar to Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 13:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 14:

Produce all documents that record, refer to, or relate to Opposer's advertising and/or promotional expenditures, or expected advertising and/or promotional expenditures, for each good offered for sale, sold and/or distributed in connection with a water bottle bearing a configuration similar to Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 14:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 15:

Produce all documents that record, refer to, or relate to any communication, oral or written, received by or sent from Opposer relating to a comparison or the similarity of the configuration of a product by Opposer and Applicant's Mark.

RESPONSE: TO REQUEST FOR PRODUCTION NO. 15:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 16:

Produce all documents that record, refer to, or relate to the use or application of Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 16:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 17:

Produce all documents that record, refer to or relate to Opposer's knowledge and awareness of (1) Applicant, (2) Applicant's Mark, and (3) Applicant's U.S. Trademark Application Serial No. 76/572,253 for Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 17:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 18:

Produce all documents that contain and/or include any reference to any third-party bottles related to this Opposition proceeding.

RESPONSE TO REQUEST FOR PRODUCTION NO. 18:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST TO REQUEST FOR PRODUCTION NO. 19:

Produce all documents that record, refer to, or relate to any inquiry, investigation, evaluation, analysis, or survey conducted by Opposer or any person acting for or on behalf of Opposer regarding any issues involved in this proceeding.

RESPONSE TO REQUEST FOR PRODUCTION NO. 19:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 20:

Produce all documents that record, refer to, or relate to Owens-Illinois or Brockaway Glass.

RESPONSE TO REQUEST FOR PRODUCTION NO. 20:

REQUEST FOR PRODUCTION NO. 21:

Produce all documents regarding, relating to or referring to goods manufactured, distributed or sold by or on behalf of Opposer that Opposer believes to be adversely affected by the registration of Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 21:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 22:

Produce all documents regarding, relating to or referring to each bottle shown in Exhibit 1 attached to the Notice of Opposition.

RESPONSE TO REQUEST FOR PRODUCTION NO. 22:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 23:

Produce all documents regarding, relating to or referring to the phrases "standard sizes in the marketplace," "standard laboratory machines," and "related bottle holders," which were used in the Notice of Opposition.

RESPONSE TO REQUEST FOR PRODUCTION NO. 23:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 24:

Produce all documents that refer or relate to bottles Opposer considers to be "Boston Rounds."

RESPONSE TO REQUEST FOR PRODUCTION NO. 24:

REQUEST FOR PRODUCTION NO. 25:

Produce all documents and communications, oral or written, related to any inquiry received by Opposer about a water bottle bearing Applicant's Mark or a similar configuration.

RESPONSE TO REQUEST FOR PRODUCTION NO. 25:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 26:

Produce all documents and communications, oral or written, that refer to or in any way relate to Applicant, or refer to or relate to Applicant's Mark or the application for Applicant's Mark, U.S. Application Serial No. 76/572,253.

RESPONSE TO REQUEST FOR PRODUCTION NO. 26:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 27:

Produce a copy of any statements and/or opinions, oral or written, obtained by Opposer or any person acting for or on behalf of Opposer regarding any of the issues in this Opposition proceeding.

RESPONSE TO REQUEST FOR PRODUCTION NO. 27:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 28:

Produce all documents that record, refer to, or relate to the costs for manufacturing a plastic water bottle by or on behalf of Opposer.

RESPONSE TO REQUEST FOR PRODUCTION NO. 28:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 29:

Produce all documents in Opposer's possession that record, refer to, or relate to costs for manufacturing a plastic water bottle by third parties.

RESPONSE TO REQUEST FOR PRODUCTION NO. 29:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 30:

Produce all documents that record, refer to, or relate to the costs of manufacturing a bottle by or on behalf of Opposer having a configuration similar to Applicant's Mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 30:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 31:

Produce all documents that record, refer to, or relate in any manner to the subject matter of this Opposition proceeding.

RESPONSE TO REQUEST FOR PRODUCTION NO. 31:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 32:

Produce a copy of all documents, other than those produced in response to any of the foregoing requests, upon which Opposer intends to rely in connection with this Opposition proceeding.

RESPONSE TO REQUEST FOR PRODUCTION NO. 32:

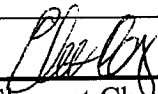
Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

REQUEST FOR PRODUCTION NO. 33:

Produce all documents identified in response to Applicant's First Set of Interrogatories to Opposer not produced in response to the above requests.

RESPONSE TO REQUEST FOR PRODUCTION NO. 33:

Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.

<div data-bbox="310 631 495 700" data-label="Text"><p>2/28/2006</p></div> <div data-bbox="237 696 308 729" data-label="Text"><p>Date</p></div> <div data-bbox="237 764 801 789" data-label="Text"><p>Z:\Client 2. © TM#TTAB#TriForest Ent v. Nalgene 76572253\TriForest's Response to Production.doc</p></div>	<div data-bbox="850 611 1007 704" data-label="Text"></div> <div data-bbox="826 683 1333 727" data-label="Text"><p>Clement Cheng, attorney for applicant</p></div> <div data-bbox="826 739 1227 779" data-label="Text"><p>Law Office of Clement Cheng</p></div> <div data-bbox="826 795 1187 835" data-label="Text"><p>17220 Newhope St Ste 127</p></div> <div data-bbox="826 849 1268 890" data-label="Text"><p>Fountain Valley, CA 92708-4283</p></div> <div data-bbox="826 905 1037 944" data-label="Text"><p>(714) 825-0555</p></div> <div data-bbox="826 961 1088 1000" data-label="Text"><p>(714) 825-0558 fax</p></div>
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PROOF OF SERVICE

In the matter of App Ser. No. 76/572,253

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On February 28, 2006, I served:

**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S FIRST SET OF REQUESTS
FOR PRODUCTION OF DOCUMENTS**

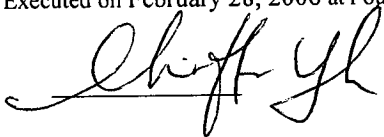
By placing true copies thereof in a sealed envelope, addressed as follows to:

Donald L. Frei
Sarah Otte Graber
WOOD, HERRON & EVANS, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202-2917
(513) 241-2324

Attorney's for Applicant Nalge Nunc International Corporation

- ☐ **BY PERSONAL SERVICE:** I caused such envelope to be delivered by hand to the offices of the addressee(s).
- ☒ **BY MAIL:** I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.
- ☒ **FEDERAL:** I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on February 28, 2006 at Fountain Valley, California.



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application, Serial No. 76/572,253)	
TriForest Enterprises, Inc.)	
)	Opposition No.: 91165809
Opposer,)	
)	
Nalge Nunc International Corporation,)	
)	
Applicant/Respondent.)	
_____)	

**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S
FIRST SET OF REQUESTS FOR ADMISSIONS**

REQUEST FOR ADMISSION NO. 1:

Admit that Applicant's Mark is different in appearance from bottles Opposer considers to be "Boston Rounds."

RESPONSE TO REQUEST FOR ADMISSION NO. 1:

Denied, in the sense that both of them look like a Boston Round bottle. Opposer sells bottles called "Boston Rounds" in the laboratory market. The Applicant's website lists a bottle also called "Boston Round," which is identically shaped like Opposer's Boston Round bottle and shares similar features. Applicant's Boston Round is similar to Opposer's because it fits the same closure, has a tethered cap that can be interchanged and shares the same dimensions.

REQUEST FOR ADMISSION NO. 2:

Admit that Opposer may produce and sell drinking water bottles having a different shape from Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 2:

Admitted. Opposer sells various general purpose bottles not limited to drinking water or laboratory use, however, due to the increase in the number of trade dress claims, and cease and desist letters received from Apogent, the scope of the trademark is broadened after registration such that applicant later claims infringement against wide variety of opposers products. Based on previous correspondence, it appears that Apogent (parent company of Nalgene) has an expansive view of the trademark scope. Furthermore, the scope of the trademark claims seems to grow over time so this admission relates only to the present time.

REQUEST FOR ADMISSION NO. 3:

Admit Opposer has sold, produced and distributed drinking water bottles that have a different shape from Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 3:

Admitted. However, Applicant's numerous trade dress claims are overbroad such that they encompass all of opposer's products. Opposer sells various bottles for a general purpose, not limited to drinking water or laboratory use however, opposer's distributors have received cease and desist letters when only a small number of factors match the numerous list of trade dress elements.

REQUEST FOR ADMISSION NO. 4:

Admit that the goods referred to in Admission No. 3 had a cap, a tether and a mouth.

RESPONSE TO REQUEST FOR ADMISSION NO. 4:

Admitted. All of Opposer's bottles have a cap and a mouth. Some of Opposer's bottles have a connector (tether) to provide convenience and prevention of loss of the cap. The bottles in reference all have a closure of 38/430, which is a generally popular neck size in laboratories. The bottles come with a choice of a tethered cap, filtered cap, a rubber septum cap or a sealed non tethered cap. Opposer's bottles that have a tethered cap serve a utility function and are essential for use in a sterile environment. If the Applicant were to succeed in registering its trademark, any person or company who manufactures a Boston Round bottle with a closure measuring 38/430 would infringe on a trademark.

REQUEST FOR ADMISSION NO. 5:

Admit that Opposer will not be harmed by the registration of Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 5:

Denied. The Opposer will be harmed financially and commercially by the registration of the Applicant's mark because the Opposer has been manufacturing and selling Boston Round bottles for a long time in the industry. Registration of Applicant's Mark would cause Opposer to infringe on a trademark each time it manufactured a Boston Round bottle with a closure measuring 38/430. Opposer and distributors will receive cease and desist letters that will harm opposer even if opposer is not sued when the trademark issues.

REQUEST FOR ADMISSION NO. 6:

Admit that Opposer filed a patent application directed to a connector tether after it became aware of Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 6:

The Opposer denies that it filed a patent application for a connector tether featured on the Boston Round bottle design after it became aware of the Applicant's Mark. Looking at the filing dates, this does not seem to be possible. Prior to the Applicant's application for trademark registration, the Opposer filed a utility and patent application for the connection tether based on its use in the culture media market. The Applicant filed a trademark application after it became aware of the Opposer's patent application.

REQUEST FOR ADMISSION NO. 7:

Admit Opposer purposely filed its patent application in preparation for the current Opposition proceeding.

RESPONSE TO REQUEST FOR ADMISSION NO. 7:

Denied. The Opposer filed a utility and patent application for its connector tether to protect its intellectual property rights to an innovative and convenient cap feature on Boston Round bottles, which it sold in the culture media market.

REQUEST FOR ADMISSION NO. 8:

Referring to the bottles shown on Exhibit 1 attached to the Notice of Opposition, admit that Applicant's Mark is different in appearance from:

- a. Product #5180, On the Trail Square Polycarbonate bottle;
- b. Product #5190, The Journeyer Polycarbonate bottle;
- c. Product #5196, The Outfitter Polycarbonate bottle;
- d. Product #4663, the Flavor Fresh Polycarbonate bottle;

e. Product #5081, the Rx Collapsible water bottle.

RESPONSE TO REQUEST FOR ADMISSION NO. 8:

There is some difference in appearance, but that is a matter of degree that can be debated. However, once the trademark issues, the opposer and its distributors will begin receiving cease and desist letters from Apogent (parent company of Nalgene) claiming trademark infringement. This will cut into sales and hurt the opposer, which is why the opposer is filing this opposition.

REQUEST FOR ADMISSION NO. 9:

Admit that the bottles Opposer considers to be "Boston Rounds" are for laboratory use only.

RESPONSE TO REQUEST FOR ADMISSION NO. 9:

Denied. Opposer and others sell versions of Boston Round bottles in various markets, and does not limit its sales for laboratory use only.

REQUEST FOR ADMISSION NO. 10:

Admit that the bottles Opposer considers to be "Boston Rounds" are not used as drinking water bottles.

RESPONSE TO REQUEST FOR ADMISSION NO. 10:

Denied. Opposer and others sell Boston Round bottle variations for all customer applications, and does not limit the use of these bottles as drinking water bottles.

RESPONSE TO REQUEST FOR ADMISSION NO. 11:

Admit that the Owens-Illinois website referenced in the Notice of Opposition does not refer to any plastic drinking water bottles.

RESPONSE TO REQUEST FOR ADMISSION NO. 11:

Not sure, applicant and opposer will have to check on this. It appears that the bottles are made of plastic, however they could very well be made of glass also.

REQUEST FOR ADMISSION NO. 12:

Admit that Owens-Illinois does not manufacture and/or provide plastic drinking water bottles.

RESPONSE TO REQUEST FOR ADMISSION NO. 12:

Not sure, Opposer does not have sufficient knowledge or information to know the purpose for which Owens-Illinois Boston Round bottles are used.

REQUEST FOR ADMISSION NO. 13:

Admit that the Brockaway Glass website referenced in the Notice of Opposition does not refer to any plastic drinking water bottles.

RESPONSE TO REQUEST FOR ADMISSION NO. 13:

Not sure, Opposer does not have sufficient knowledge or information re: the Brockaway Glass company product.

REQUEST FOR ADMISSION NO. 14:

Admit that Brockaway Glass does not manufacture and/or provide plastic drinking water bottles.

RESPONSE TO REQUEST FOR ADMISSION NO. 14:

Not sure, Opposer does not have sufficient knowledge or information to know the purpose for which Brockaway Glass Boston Round bottles are used. However the plastic water bottles appeared to be not for drinking. Obviously, someone can drink from the water bottle however the opposer will investigate this matter.

REQUEST FOR ADMISSION NO. 15:

Admit that the "utility patent" referred to in Paragraph 15 in the Notice of Opposition, as re-numbered by Applicant, refers to Utility Patent Application Serial No. 10/759,659.

RESPONSE TO REQUEST FOR ADMISSION NO. 15:

Admitted. Opposer admits that the utility patent application serial number 10/759,659 accurately refers to the utility and patent application the Opposer filed to protect its intellectual property rights to the connection tether feature on Boston Round bottles.

REQUEST FOR ADMISSION NO. 16:

Admit that there are numerous alternative designs for plastic drinking water bottles that are equally efficient as Applicant's Bottle Configuration.

RESPONSE TO REQUEST FOR ADMISSION NO. 16:

Denied, the design of the bottle configuration at issue is particularly optimized from an engineering standpoint and has numerous functional advantages that the applicant wishes to monopolize using the trademark application and claim for trade dress.

REQUEST FOR ADMISSION NO. 17:

Admit that there are numerous alternative designs for each feature of plastic drinking water bottles that are equally efficient as the features in Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 17:

Denied, each design element of the bottle configuration at issue is particularly optimized from an engineering standpoint and has a unique functional advantage that the applicant wishes to monopolize using the trademark application and claim for trade dress.

REQUEST FOR ADMISSION NO. 18:

Admit that Applicant's Mark is not the only design available for a plastic drinking water bottle.

RESPONSE TO REQUEST FOR ADMISSION NO. 18:

Admitted. Applicant's mark is not the only variation of the Boston Round design. Other bottle manufacturers, also use modified versions of their Boston Round design bottles as plastic drinking water bottles.

REQUEST FOR ADMISSION NO. 19:

Admit that there are alternative designs for plastic drinking water bottles that are less expensive to manufacture than plastic drinking water bottles bearing Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 19:

Denied. Opposer incurred substantial cost to make numerous design modifications after receiving threats from Apogent. Bottle manufacturers, including Applicant, sell less expensive bottles that are variations of the plastic drinking water bottles bearing Applicant's Mark. However, opposer would have saved a substantial amount of money if applicant did not make any trademark claims.

REQUEST FOR ADMISSION NO. 20:

Admit that Opposer may provide plastic water bottles with different configurations that are equally efficient as Applicant's goods despite the registration of Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 20:

Denied, Opposer will continue to provide bottles that can be used for any and all applications that a customer chooses to apply, including but not limited to drinking water. Opposer would lose the benefit of each design element of the bottle configuration at issue that is

optimized from an engineering standpoint and has a unique functional advantage that the applicant wishes to monopolize using the trademark application and claim for trade dress.

REQUEST FOR ADMISSION NO. 21:

Admit that the bottles shown on Exhibit 1 attached to the Notice of Opposition are equally efficient as goods bearing Applicant's Mark.

RESPONSE TO REQUEST FOR ADMISSION NO. 21:

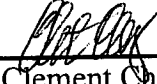
Opposer maintains that each design element of the bottle configuration at issue is particularly optimized from an engineering standpoint and has a unique functional advantage that the applicant wishes to monopolize using the trademark application and claim for trade dress.

REQUEST FOR ADMISSION NO. 22:

Admit that Opposer will not be harmed in any way should Applicant's Mark register.

RESPONSE TO REQUEST FOR ADMISSION NO. 22:

Denied. Opposer will be harmed financially and commercially should the applicant's mark be registered.

<p>2/28/06</p> <hr/> <p>Date</p> <p><small>Z:\Client 2. @ TM\TTAB\TriForest Ent v. Nalgene 76572253\TriForest's Response to Applicant's Request for Admissions.doc</small></p>	<p></p> <hr/> <p>Clement Cheng, attorney for applicant</p> <p>Law Office of Clement Cheng</p> <p>17220 Newhope St Ste 127</p> <p>Fountain Valley, CA 92708-4283</p> <p>(714) 825-0555</p> <p>(714) 825-0558 fax</p>
--	---

PROOF OF SERVICE

In the matter of App Ser. No. 76/572,253

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On February 28, 2006, I served:

TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S REQUEST FOR ADMISSION

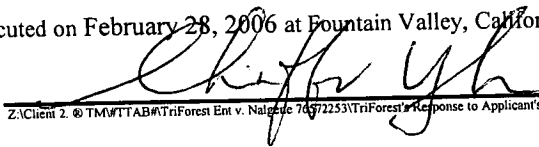
By placing true copies thereof in a seal envelope, addressed as follows to:

Donald L. Frei
Sarah Otte Graber
WOOD, HERRON & EVANS, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202-2917
(513) 241-2324

Attorney's for Applicant Nalge Nunc International Corporation

- ☐ BY PERSONAL SERVICE: I caused such envelope to be delivered by hand to the offices of the addressee(s).
- ☒ BY MAIL: I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.
- ☒ FEDERAL: I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on February 28, 2006 at Fountain Valley, California.


Z:\Client 2.0\TM\TTAB\TriForest Ent v. Nalge.doc 76/572253\TriForest's Response to Applicant's Request for Admissions.doc

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF:

TriForest Enterprises, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91165809
)	Application No.:76572253
Nalge Nunc International Corporation,)	Mark: plastic water bottle (design only)
)	
Applicant.)	

PROTECTIVE ORDER
AND CONFIDENTIALITY AGREEMENT

Applicant hereby submits the proposed Protective Order to the the Trademark Trial and Appeal Board for approval. Applicant proposes that if, in the course of this Opposition proceeding, either party has occasion to disclose information deemed by the disclosing party to be sensitive, confidential, personal, proprietary and/or protected by a statutory or other legal privilege, and that is not public knowledge ("Confidential Material"), the following procedures be employed and the following restrictions be used to govern:

1. Any documents, answers to interrogatories, answers to deposition questions, affidavits, declarations, responses to requests for admission, samples, objects, or any other information, materials or portions thereof (hereinafter "Material") provided by or on behalf of either party (or any of their attorneys or other agents) to the other during the pendency of this proceeding may be clearly designated and marked, in whole or in part, "**Confidential**" by Counsel for Applicant or counsel for Opposer, producing such Material at the time of production thereof unless otherwise agreed by the parties in writing.

To the extent that such Material is so marked "Confidential", such Material together with any copies of such Material, abstracts, summaries, or information derived therefrom, and any notes or other record regarding the contents thereof, is hereinafter referred to as "Confidential Material".

2. Counsel for Applicant or counsel for Opposer may disclose or discuss Confidential Material only to a "Qualified Person" as defined in paragraph 3, who agrees to

Exhibit 4- Opposition No. 91165809,
TriForest Enterprises, Inc. v. Nalge Nunc
International Corporation, offered by Nalge
Nunc International Corporation

maintain such information in confidence and who has need for such information to assist in the preparation and trial of this proceeding and only for the purpose of said preparation and trial; said Qualified Persons shall not disclose or discuss Confidential Material to any other person and shall not use such information for any purpose other than the preparation and trial of this proceeding.

3. As herein used, the term "Qualified Person" means:

(a) The outside trial counsel for the Applicant to this case, including said counsel's partner and associate attorneys and clerical employees for purpose of this Opposition proceeding.

(b) The counsel for the Opposer to this case, including said counsel's partner and associate attorneys and clerical employees for purpose of this Opposition proceeding.

(c) Subject to signing secrecy agreements pursuant to paragraph 4, consulting or testifying experts (exclusive of present and former shareholders, directors, officers, employees, agents or consultants of a party or of any other person, firm or corporation engaged in the provision or sale of the types of goods or services to which this proceeding is related) engaged by counsel for Applicant or counsel for Opposer with respect to the subject matter of Confidential Material for purposes of this case.

(d) U.S. Trademark Trial and Appeal Board personnel.

(e) Present and former shareholders, directors, officers, employees, agents, and consultants of a party to this proceeding are expressly excluded from the definition of "Qualified Person" and shall not be entitled to review or discuss Confidential Material.

4. Counsel for Applicant or counsel for Opposer in possession of Confidential Material received from other party shall notify counsel for Applicant or counsel for Opposer of the name of any person to whom disclosure of such Confidential Material is made pursuant to subsections (a), (b), and (c) of paragraph 3 of this Stipulation. Each person designated in paragraphs 3(a), 3(b), 3(c) shall, in turn, be informed of this Stipulation and Protective Order, hold such Confidential Material in confidence and in a secure and safe place, shall not use it for any purpose other than the purposes of this Opposition proceeding, and, prior to disclosure to such person of such Confidential Material, shall be required to sign the affidavit of confidentiality annexed hereto as Exhibit A indicating that in the form as follows:

"The undersigned has read the Stipulated Order between TriForest Enterprises, Inc., and Nalge Nunc International Corporation issued or signed by the Trademark Trial and Appeal Board on _____, 2006 agrees:

- (1) that he/she is not a present or former shareholder, director, officer, employee, agent or consultant of a party or of any other person, firm or corporation engaged in the provision or sale of the types of goods or services to which this proceeding is related;
- (2) that he/she shall fully abide by the terms of said Stipulated Protective Order and Confidentiality Agreement;
- (3) that upon threat of penalty of contempt, he/she shall not disclose Confidential Material to or discuss Confidential material with any person who is not authorized pursuant to the terms of said Stipulated Protective Order to receive the disclosure thereof and who has not signed an affidavit of confidentiality as therein provided; and
- (4) that he/she shall not use such Confidential Material for any purposes other than for the purpose of this proceeding.
- (5) that he/she submits to the jurisdiction of the Trademark Trial and Appeal Board for the enforcement of this Order."

A copy of each signed affidavit shall be furnished to the other party within ten (10) days after execution thereof.

5. In the event that the receiving party disagrees with the designation and marking by any producing party of Material as "Confidential," as described in Paragraph 2 above, then the parties shall try first to resolve such dispute on an informal basis before presenting the dispute to the Trademark Trial and Appeal Board by motion or otherwise. The party that disagrees Material should be designated and marked as Confidential shall specifically identify the designation of material being challenged. The party seeking to uphold the "Confidential" designation shall have the burden of proof.

6. The subject matter of any deposition given by any present or former officer, employee, agent, or consultant of a party and the original and all copies of the transcript of any such deposition shall be deemed to come within the term "Confidential Material" referred to in paragraph 1 of this Stipulation for a period ending thirty (30) days after the transcript becomes available to counsel for Applicant or counsel for Opposer. On or before the thirtieth day after any such transcript becomes available to counsel for Applicant or counsel for Opposer, such transcript may be designated and marked, in whole or in part, "Confidential" by the party whose

present or former officer, employee, agent or consultant gave such deposition, and the portions of the transcript of the deposition so marked shall be subject to the provisions of this Stipulation. A party designating a portion of a deposition transcript shall use reasonable good faith efforts to identify only information that is truly Confidential Material under the terms of this Stipulation.

7. Where only a part of the material furnished or produced by a party or a part of the transcript of any deposition given by any present or former officer, employee, agent, or consultant of a party is Confidential Material, counsel for Applicant or counsel for Opposer receiving such material or transcript shall delete therefrom Confidential Material before disclosing such Material or transcript to any person other than Qualified Persons designated in paragraph 3.

8. Deletions made from any Material or transcript in accordance with the terms of this Stipulation shall not affect the admissibility of any such material or transcript in evidence in this action.

9. If any Confidential Material is summarized, discussed or quoted any deposition or hearing, or at the trial of this proceeding, all person other than those otherwise to whom disclosure is permitted hereunder and outside counsel and Board personnel, shall be excluded from such portion of the deposition, hearing, or trial.

10. Any transcripts, exhibits or documents that are filed with the Board and that comprise, embody, summarize, discuss, or quote from Confidential Material shall be filed with the Trademark Trial and Appeal Board in a sealed envelope bearing the caption "Confidential Material" with the following notation: "This envelope contains Confidential Material to be opened only by or as ordered by the Trademark Trial and Appeal Board.

11. Nothing herein shall impose any restriction on the use or disclosure by a party of its own documents or information. Nor shall this Stipulation and Protective Order be construed to prevent any party or its counsel from making use of documents or information which were lawfully available to the public or lawfully in the party's possession prior to another party providing it. Nothing in this Stipulation and Protective Order shall be construed to alter any confidentiality agreements relating to any information involved in this matter.

12. This Protective Order shall not constitute a waiver of either party's rights to object to any discovery request as provided under the Trademark Rules of Practice and federal law.

13. The inadvertent production of any Material without being designated and marked as "Confidential" will not be deemed a waiver of any claim that the Material is "Confidential

Material." If Material believed by a party to be entitled to protection as Confidential Material is inadvertently produced, the producing party may notify the receiving party, and the receiving party shall thereafter treat the information as Confidential Material. If, prior to receiving such notice, the receiving party has disseminated the Confidential Material to individuals not authorized to receive it under this Stipulation, the receiving party shall make a reasonable effort to retrieve the Confidential Material or otherwise assure that the recipient(s) maintain the confidentiality of the Confidential Material. Disclosure of the Confidential Material prior to the producing party's notice will not be deemed a violation of this Stipulation.

14. Nothing in this Protective Order shall prejudice a party from seeking amendment of this Order, broadening or restricting the rights of access to and use of Confidential Material, subject to Order by the Board.

15. The provisions of this Stipulation and Protective Order shall survive the termination of this proceeding. After the conclusion of this proceeding, including all appeals, counsel for Application or counsel for Opposer shall return all Confidential Material to the producing party, within thirty (30) days after a final judgment herein or settlement of this action.

Nalge Nunc International Corporation

Sarah Otte Graber, Esq.
Theodore R. Remaklus
Wood, Herron and Evans
2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202-2917

Attorneys for Applicant
Nalge Nunc International Corporation

So Ordered this ____ day of _____, 2006

Administrative Trademark Judge

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF:

TriForest Enterprises, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91165809
)	Application No.: 76572253
Nalge Nunc International Corporation,)	Mark: plastic water bottle (design only)
)	
Applicant.)	
)	

**ACKNOWLEDGMENT OF PROTECTIVE ORDER
AND AGREEMENT TO BE BOUND**

I, _____ state as follows:

1. I reside at _____ in the city and county of _____
and state of _____;
2. I am not a present or former shareholder, director, officer, employee, agent or consultant of a party or of any other person, firm or corporation engaged in the provision or sale of the types of goods or services to which this proceeding is related;
3. I have read and understand the Protective Order and Confidentiality Agreement entered in this opposition proceeding and agree to abide by the terms of and be bound by the provisions of the Protective Order and Confidentiality Agreement;
4. I consent to the exercise of personal jurisdiction by the trademark Trial and Appeal Board for purposes of enforcing the terms of the Protective Order;
5. I will not disclose Confidential Material to or discuss Confidential Material with any person who is not authorized pursuant to the terms of said Stipulated Protective Order and Confidentiality Agreement to receive the disclosure thereof and who has not signed an affidavit of confidentiality as therein provided, except solely for purposes of this opposition proceeding, any information designated as Confidential Information defined by the Protective Order and Confidentiality Agreement, except as provided therein.

Dated

Name and Signature

WOOD, HERRON & EVANS, LLP

BRUCE TITTEL
DONALD F. FREI
DAVID S. STALLARD
J. ROBERT CHAMBERS
GREGORY J. LUNN
KURT L. GROSSMAN
CLEMENT H. LUKEN, JR.
THOMAS J. BURGER
GREGORY F. AHRENS
WAYNE L. JACOBS
KURT A. SUMME
KEVIN G. ROONEY
KEITH R. HAUPT
THEODORE R. REMAKLUS
THOMAS W. HUMPHREY
SCOTT A. STINEBRUNER
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FACSIMILE: 513-241-6234
WEBSITE: www.whepatent.com

PATENT, TRADEMARK, COPYRIGHT
AND UNFAIR-COMPETITION LAW
AND RELATED LITIGATION

EDMUND P. WOOD 1923-1968
TRUMAN A. HERRON 1935-1976
EDWARD B. EVANS 1936-1971

JOSEPH R. JORDAN
C. RICHARD EBY
DAVID E. PRITCHARD

KATHRYN E. SMITH
P. ANDREW BLATT, Ph.D.
DAVID E. JEFFERIES
WILLIAM R. ALLEN, Ph.D.
JOHN PAUL DAVIS
DOUGLAS A. SCHOLER
BRETT A. SCHATZ
DAVID W. DORTON
SARAH OTTE GRABER
STEVEN W. BENINTENDI, Ph.D.
RANDALL S. JACKSON, JR.

OF COUNSEL
JOHN D. POFFENBERGER
DAVID J. JOSEPHIC
THOMAS W. FLYNN
J. DWIGHT POFFENBERGER, JR.
BRADLEY D. BECK

March 27, 2006

Via Fax and Email

Clement Cheng, Esq.
Law Offices of Clement Cheng
17220 Newhope Street, Suite 127
Fountain Valley, California 92703

Re: U.S. Trademark Application Serial No. 76/572,253
Opposition No. 91165809
TriForest Enterprises, Inc. v. Nalge Nunc International Corporation
Our Ref.: NAC-125OP

Dear Mr. Cheng:

We have now had an opportunity to fully examine what we assume to be your client's responses to Nalge Nunc's discovery requests. We find these responses completely insufficient and unresponsive. Not only do they not answer the questions presented, they instead provide misstated information, hearsay, and speculation. Moreover, TriForest has claimed numerous baseless objections. Lastly, we note that the answers to Applicant's Interrogatories are not signed by your client, which is required under Trademark Trial and Appeal Board practice. TMBP § 405.04(c).

With respect to the responses by TriForest to Applicant's first set of discovery, there are a number of deficiencies that must be corrected. Globally, TriForest objected to the admission requests, document requests and interrogatories to the extent they sought confidential or trade secret information absent entry of an Agreed Protective Order. Since it objected on this basis, we would have expected to receive a proposed protective order from TriForest, but none was provided. Therefore, we have drafted and hereto attach a proposed Stipulated Protective Order for the parties to enter. This should resolve any objections based on confidentiality. Please have this Order immediately signed by your client and promptly returned to us, so we may, in turn, have it executed by our client. Once filed with the TTAB, which can be done by tomorrow, please produce all documents and provide complete responses to each interrogatory to which information was withheld on that basis.

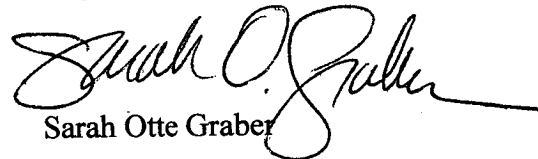
TriForest also refused to respond to numerous Interrogatories, for example, Interrogatory Nos. 7, 18, 20-23, 27, and 36, on the grounds that the "products are difficult to define." In these

Clement Cheng, Esq.
March 27, 2006
Page 2 of 2

responses, TriForest goes into an extraneous and lengthy explanation about patent limitations. These responses are completely unsatisfactory, nonresponsive, evasive and incomplete. Applicant is unclear what is difficult about identifying TriForest's products that bear a similar configuration to "Applicant's Bottle Configuration," which is explicitly defined in Applicant's "Instructions and Definitions of Terms," Paragraph C, as being the mark depicted in U.S. Application Serial No. 76/572,253. There is no doubt that Applicant's mark is clearly shown on the drawing page of this application. 37 CFR § 2.52 explicitly requires that "[a] drawing depicts the mark sought to be registered." Nothing could be more understandable than a picture of Applicant's mark. Therefore, this blanket response that Opposer provides to Applicant's Interrogatories is completely baseless and unacceptable. Moreover, TriForest understood the definition of "Applicant's Bottle Configuration" enough to attempt to answer other discovery requests that made reference to it, such as Interrogatory Nos. 9, 19, and 26. Thus, TriForest has simply avoided answering Applicant's very straightforward requests on the baseless disguise of confusion or misunderstanding. Applicant does not buy this.

Except for its Responses to Interrogatory Nos. 2, 10 and 34, Applicant considers Opposer's Responses to its discovery requests to be incomplete, insufficient or unanswered and its objections thereto to be baseless. Applicant will let stand Opposer's Admissions as they are answered. Therefore, unless your client provides clear, sufficient and supplemental answers, under oath, with supporting documents, as requested in Applicant's Interrogatories and Document Requests, by March 29, 2006, Applicant will have no other choice but to file a Motion to Compel.

Regards,


Sarah Otte Graber

cc: Denise Riemann, Ph.D., Esq. (w/ Enclosures)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF:

TriForest Enterprises, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91165809
)	Application No.:76572253
Nalge Nunc International Corporation,)	Mark: plastic water bottle (design only)
)	
Applicant.)	
)	

**STIPULATED PROTECTIVE ORDER
AND CONFIDENTIALITY AGREEMENT**

IT IS HEREBY STIPULATED AND AGREED by and between Opposer and Applicant, subject to the approval of the Trademark Trial and Appeal Board, that if, in the course of this Opposition proceeding, either party has occasion to disclose information deemed by the disclosing party to be sensitive, confidential, personal, proprietary and/or protected by a statutory or other legal privilege, and that is not public knowledge ("Confidential Material"), the following procedures shall be employed and the following restrictions shall govern:

1. Any documents, answers to interrogatories, answers to deposition questions, affidavits, declarations, responses to requests for admission, samples, objects, or any other information, materials or portions thereof (hereinafter "Material") provided by or on behalf of either party (or any of their attorneys or other agents) to the other during the pendency of this proceeding may be clearly designated and marked, in whole or in part, "Confidential" by Counsel for Applicant or counsel for Opposer, producing such Material at the time of production thereof unless otherwise agreed by the parties in writing.

To the extent that such Material is so marked "Confidential", such Material together with any copies of such Material, abstracts, summaries, or information derived therefrom, and any notes or other record regarding the contents thereof, is hereinafter referred to as "Confidential Material".

2. Counsel for Applicant or counsel for Opposer may disclose or discuss Confidential Material only to a "Qualified Person" as defined in paragraph 3, who agrees to

maintain such information in confidence and who has need for such information to assist in the preparation and trial of this proceeding and only for the purpose of said preparation and trial; said Qualified Persons shall not disclose or discuss Confidential Material to any other person and shall not use such information for any purpose other than the preparation and trial of this proceeding.

3. As herein used, the term "Qualified Person" means:

(a) The outside trial counsel for the Applicant to this case, including said counsel's partner and associate attorneys and clerical employees for purpose of this Opposition proceeding.

(b) The counsel for the Opposer to this case, including said counsel's partner and associate attorneys and clerical employees for purpose of this Opposition proceeding.

(c) Subject to signing secrecy agreements pursuant to paragraph 4, consulting or testifying experts (exclusive of present and former shareholders, directors, officers, employees, agents or consultants of a party or of any other person, firm or corporation engaged in the provision or sale of the types of goods or services to which this proceeding is related) engaged by counsel for Applicant or counsel for Opposer with respect to the subject matter of Confidential Material for purposes of this case.

(d) U.S. Trademark Trial and Appeal Board personnel.

(e) Present and former shareholders, directors, officers, employees, agents, and consultants of a party to this proceeding are expressly excluded from the definition of "Qualified Person" and shall not be entitled to review or discuss Confidential Material.

4. Counsel for Applicant or counsel for Opposer in possession of Confidential Material received from other party shall notify counsel for Applicant or counsel for Opposer of the name of any person to whom disclosure of such Confidential Material is made pursuant to subsections (a), (b), and (c) of paragraph 3 of this Stipulation. Each person designated in paragraphs 3(a), 3(b), 3(c) shall, in turn, be informed of this Stipulation and Protective Order, hold such Confidential Material in confidence and in a secure and safe place, shall not use it for any purpose other than the purposes of this Opposition proceeding, and, prior to disclosure to such person of such Confidential Material, shall be required to sign the affidavit of confidentiality annexed hereto as Exhibit A indicating that in the form as follows:

"The undersigned has read the Stipulated Order between TriForest Enterprises, Inc., and Nalge Nunc International Corporation issued or signed by the Trademark Trial and Appeal Board on _____, 2006 agrees:

- (1) that he/she is not a present or former shareholder, director, officer, employee, agent or consultant of a party or of any other person, firm or corporation engaged in the provision or sale of the types of goods or services to which this proceeding is related;
- (2) that he/she shall fully abide by the terms of said Stipulated Protective Order and Confidentiality Agreement;
- (3) that upon threat of penalty of contempt, he/she shall not disclose Confidential Material to or discuss Confidential material with any person who is not authorized pursuant to the terms of said Stipulated Protective Order to receive the disclosure thereof and who has not signed an affidavit of confidentiality as therein provided; and
- (4) that he/she shall not use such Confidential Material for any purposes other than for the purpose of this proceeding.
- (5) that he/she submits to the jurisdiction of the Trademark Trial and Appeal Board for the enforcement of this Order."

A copy of each signed affidavit shall be furnished to the other party within ten (10) days after execution thereof.

5. In the event that the receiving party disagrees with the designation and marking by any producing party of Material as "Confidential," as described in Paragraph 2 above, then the parties shall try first to resolve such dispute on an informal basis before presenting the dispute to the Trademark Trial and Appeal Board by motion or otherwise. The party that disagrees Material should be designated and marked as Confidential shall specifically identify the designation of material being challenged. The party seeking to uphold the "Confidential" designation shall have the burden of proof.

6. The subject matter of any deposition given by any present or former officer, employee, agent, or consultant of a party and the original and all copies of the transcript of any such deposition shall be deemed to come within the term "Confidential Material" referred to in paragraph 1 of this Stipulation for a period ending thirty (30) days after the transcript becomes available to counsel for Applicant or counsel for Opposer. On or before the thirtieth day after any such transcript becomes available to counsel for Applicant or counsel for Opposer, such transcript may be designated and marked, in whole or in part, "Confidential" by the party whose

present or former officer, employee, agent or consultant gave such deposition, and the portions of the transcript of the deposition so marked shall be subject to the provisions of this Stipulation. A party designating a portion of a deposition transcript shall use reasonable good faith efforts to identify only information that is truly Confidential Material under the terms of this Stipulation.

7. Where only a part of the material furnished or produced by a party or a part of the transcript of any deposition given by any present or former officer, employee, agent, or consultant of a party is Confidential Material, counsel for Applicant or counsel for Opposer receiving such material or transcript shall delete therefrom Confidential Material before disclosing such Material or transcript to any person other than Qualified Persons designated in paragraph 3.

8. Deletions made from any Material or transcript in accordance with the terms of this Stipulation shall not affect the admissibility of any such material or transcript in evidence in this action.

9. If any Confidential Material is summarized, discussed or quoted in any deposition or hearing, or at the trial of this proceeding, all person other than those otherwise to whom disclosure is permitted hereunder and outside counsel and Board personnel, shall be excluded from such portion of the deposition, hearing, or trial.

10. Any transcripts, exhibits or documents that are filed with the Board and that comprise, embody, summarize, discuss, or quote from Confidential Material shall be filed with the Trademark Trial and Appeal Board in a sealed envelope bearing the caption "Confidential Material" with the following notation: "This envelope contains Confidential Material to be opened only by or as ordered by the Trademark Trial and Appeal Board.

11. Nothing herein shall impose any restriction on the use or disclosure by a party of its own documents or information. Nor shall this Stipulation and Protective Order be construed to prevent any party or its counsel from making use of documents or information which were lawfully available to the public or lawfully in the party's possession prior to another party providing it. Nothing in this Stipulation and Protective Order shall be construed to alter any confidentiality agreements relating to any information involved in this matter.

12. This Protective Order shall not constitute a waiver of either party's rights to object to any discovery request as provided under the Trademark Rules of Practice and federal law.

13. The inadvertent production of any Material without being designated and marked as "Confidential" will not be deemed a waiver of any claim that the Material is "Confidential

Material." If Material believed by a party to be entitled to protection as Confidential Material is inadvertently produced, the producing party may notify the receiving party, and the receiving party shall thereafter treat the information as Confidential Material. If, prior to receiving such notice, the receiving party has disseminated the Confidential Material to individuals not authorized to receive it under this Stipulation, the receiving party shall make a reasonable effort to retrieve the Confidential Material or otherwise assure that the recipient(s) maintain the confidentiality of the Confidential Material. Disclosure of the Confidential Material prior to the producing party's notice will not be deemed a violation of this Stipulation.

14. Nothing in this Protective Order shall prejudice a party from seeking amendment of this Order, broadening or restricting the rights of access to and use of Confidential Material, subject to Order by the Board.

15. The provisions of this Stipulation and Protective Order shall survive the termination of this proceeding. After the conclusion of this proceeding, including all appeals, counsel for Application or counsel for Opposer shall return all Confidential Material to the producing party, within thirty (30) days after a final judgment herein or settlement of this action.

TriForest Enterprises, Inc.,

Nalge Nunc International Corporation

Clement Cheng, Esq.
Law Offices of Clement Cheng
17220 Newhope Street, Suite 127
Fountain Valley, California 92703

Attorney for Opposer
TriForest Enterprises, Inc.,

Sarah Otte Graber, Esq.
Theodore R. Remaklus
Wood, Herron and Evans
2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202-2917

Attorneys for Applicant
Nalge Nunc International Corporation

So Ordered this _____ day of _____, 2006

Administrative Trademark Judge

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF:

TriForest Enterprises, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91165809
)	Application No.: 76572253
Nalge Nunc International Corporation,)	Mark: plastic water bottle (design only)
)	
Applicant.)	
)	

**ACKNOWLEDGMENT OF PROTECTIVE ORDER
AND AGREEMENT TO BE BOUND**

I, _____ state as follows:

1. I reside at _____ in the city and county of _____
_____ and state of _____;
2. I am not a present or former shareholder, director, officer, employee, agent or consultant of a party or of any other person, firm or corporation engaged in the provision or sale of the types of goods or services to which this proceeding is related;
3. I have read and understand the Protective Order and Confidentiality Agreement entered in this opposition proceeding and agree to abide by the terms of and be bound by the provisions of the Protective Order and Confidentiality Agreement;
4. I consent to the exercise of personal jurisdiction by the trademark Trial and Appeal Board for purposes of enforcing the terms of the Protective Order;
5. I will not disclose Confidential Material to or discuss Confidential Material with any person who is not authorized pursuant to the terms of said Stipulated Protective Order and Confidentiality Agreement to receive the disclosure thereof and who has not signed an affidavit of confidentiality as therein provided, except solely for purposes of this opposition proceeding, any information designated as Confidential Information defined by the Protective Order and Confidentiality Agreement, except as provided therein.

Dated

Name and Signature

SARAH OTTE GRABER

From: Clement Cheng [law@clemcheng.com]
Sent: Tuesday, March 28, 2006 11:00 PM
To: Sarah Otte Graber
Subject: RE: Trademark Opposition No. 91165809 TriForest V. Nalg Nunc International

March 28, 2006

By Fax, eMail

Donald L. Frei, Sarah Otte Graber
WOOD, HERRON & EVANS, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202-2917
(513) 241-2324

RE: Opposition to Trademark 76/572,235

Dear Ms Graber:

Thank you for bringing to my attention that the interrogatories were not signed according to TMBP 405.04(c). This was an oversight on my part and I will obtain the signature tomorrow. I will send you the signature page and verification.

There are two ways that the scope of the mark can be interpreted. The mark can either be a general Boston Round with a tether that has been sold for some time by a variety of entities, or the mark can be more narrowly defined as something that is substantially identical to the drawing that has been filed. The closest thing that Triforest has sold to the trademark is the teal colored bottle, of which photographs have been produced. If Nalgene's position were that the teal color model produced in the electronic documents is different than the trademark as claimed which is at issue, the opposer would not have sold any of these. This would mean that Triforest has never used Nalgene's trademark. On the other hand, if the teal colored bottle would be considered infringing then the Boston Round with a tether cap is being claimed, and in this case Triforest along with many other companies would have sold such a configuration.

Please let me know if you consider the teal colored bottle to be infringing the trademark. This will allow me to supplement answers. My view would be that the thicker grip and different ornamental features would avoid a likelihood of confusion so that the teal Triforest bottle is not within of the scope of the rights claimed. However, I believe that this is something that we can discuss and come to a resolution on, on our own, without the need for a discovery motion.

Please resend your letter in PDF format. The scan .jpeg and faxed .tiff has very low resolution.

Yours truly,

Exhibit 6 - Opposition No. 91165809,
TriForest Enterprises, Inc. v. Nalg Nunc
International Corporation, offered by Nalg
Nunc International Corporation

3/29/2006

Clement Cheng, Esq.

From: Sarah Otte Graber [mailto:sgraber@whepatent.com]
Sent: Monday, March 27, 2006 8:03 PM
To: law
Subject: Trademark Opposition No. 91165809 TriForest V. Nalg Nunc International

Dear Mr. Cheng,

Please see my attached letter and Stipulated Protective Order.

Regards,

Sarah Otte Graber
Wood Herron & Evans
2700 Carew Tower
411 Vine Street
Cincinnati, Ohio USA 45202
p-513.241.2324
f-513.241.2324

sgraber@whepatent.com

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3/29/2006

SARAH OTTE GRABER

From: Clement Cheng [law@clemcheng.com]
Sent: Wednesday, March 29, 2006 3:10 PM
To: denise.riemann@fishersci.com
Cc: Sarah Otte Graber
Subject: photograph of side-by-side comparison



Side by Side
Comparison.JPG (1..

Denise Riemann:

This is a photograph of the old narrow mouth Triforest bottle next to the narrow mouth Nalgene bottle. We have never discussed a high-resolution side-by-side comparison photograph. The Triforest website has not been updated and shows the old bottles, but at low resolution. Nalgene has stated that the new narrow mouth Triforest bottle is not infringing (this is the one with the ribs on the shoulders and a swirled cap). Triforest would like to sell the old narrow mouth bottle and this is the motivation for the opposition, if Triforest is successful with the opposition, Triforest plans to change the molds back to sell the old narrow mouth bottle design.

For discovery purposes, I must know if after looking at the high resolution side-by-side comparison photograph, whether Nalgene considers the old Triforest narrow mouth bottle to be infringing. The discovery asks for information regarding Triforest's design, sales and other details of the old Triforest narrow mouth bottle.

Clement Cheng, Esq.
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Please reply to law@clemcheng.com
cc: to outside counsel Sara Graber





01-26-2004

U.S. Patent & TMOft/TM Mail Rcpt Dt. #72

TRADEMARK

Applicant: Nalge Nunc International Corporation
Address: 75 Panorama Creek Drive, Rochester, New York 14602-0365

Date of First Use Anywhere: At least as early as April 19, 1992
Date of First Use in Commerce: At least as early as April 19, 1992
Goods: Plastic water bottle, sold empty, in International Class 21.

Mark: The mark consists of a plastic water bottle as shown, namely, a plastic water bottle having a transparent, generally cylindrical container body with rounded shoulders interconnecting the upper and lower extremities of a cylindrical sidewall to a relatively narrow container neck and a generally flat, circular container bottom, respectively; an opaque screw cap releasably engaged with threads on the upper portion of the neck and having a button connected to the center of its top surface via a short stem; and a strap terminating in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, wherein the ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately 0.4 and the ratio of the height of the generally cylindrical container body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8.

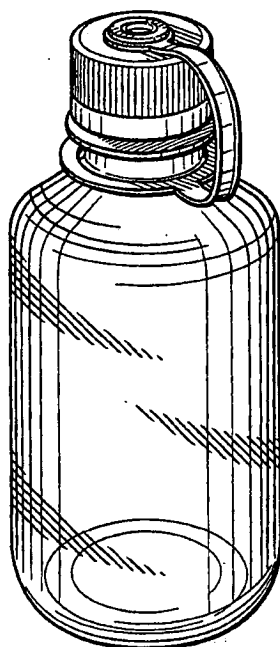


Exhibit 8- Opposition No. 91165809,
TriForest Enterprises, Inc. v. Nalge Nunc
International Corporation, offered by Nalge
Nunc International Corporation

U.S. Patent & TM Ofc/TM



76572253

DRAWING PAGE

Serial No. 76/572,253
THE CONFIGURATION OF A
PLASTIC WATER BOTTLE, SOLD
EMPTY

